

ESTTA Tracking number: **ESTTA673147**

Filing date: **05/19/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92061150
Party	Plaintiff Fashion TV Programmgesellschaft mbH
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Attachments	FTV Opposition to Motion To Dismiss 5.19.2015.pdf(238271 bytes ) Ex. A.pdf(952374 bytes ) Ex. B.pdf(309229 bytes ) Ex. C.pdf(21741 bytes ) Ex. D.pdf(81848 bytes ) Ex. E.pdf(63740 bytes ) Ex. F.pdf(974384 bytes ) Ex. G.pdf(20806 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

FASHION TV PROGRAMMGESELLSCHAFT mbH	)	
	)	
Petitioner/Plaintiff,	)	
	)	Cancellation No. 92061150
v.	)	
	)	Registration No. 2,945,407
BIGFOOT ENTERTAINMENT, INC.,	)	
	)	
Respondent/Defendant.	)	
	)	
	)	

**PETITIONER’S OPPOSITION TO RESPONDEENT’S MOTION TO DISMISS UNDER  
RULE 12(b)(6) FED. R. CIV. P. FOR LACK OF STANDING**

Petitioner, FASHION TV PROGRAMMGESELLSCHAFT mbH (“Petitioner”), through its attorneys, Dunnington, Bartholow & Miller LLP, respectfully submits this brief in opposition to Petitioner BIGFOOT ENTERTAINMENT, INC.’s (“Respondent”) motion to dismiss for lack of standing. This brief is timely filed pursuant to 37 C.F.R. § 2.127. As explained below, Petitioner has adequately alleged standing based upon Respondent’s sending of cease-and-desist letters to Petitioner and its distributors in the United States as well as Respondent’s initiation of proceedings against Petitioner’s website in the World Intellectual Property Organization (“WIPO”). A proposed Amended Petition for Cancellation is annexed hereto as Exhibit A. Fed. R. Civ. P. 15.

**COUNTER-STATEMENT OF FACTS**

Petitioner is a 24/7 television network launched from Paris in 1997. (Exhibit B). It has broadcast its content in the United States continuously since 1998. (Exhibit B). CHUM, Ltd., Respondent’s acknowledged predecessor in interest, sued Petitioner in the Southern District of

New York in 1998. (Exhibit B). *Chum Ltd. v. Lisowski*, 198 F.Supp.2d 530 (S.D.N.Y. April 18, 2002) *rehearing denied* 2002 WL 1143208, 63U.S.P.Q.2d 1578 (May 29, 2002). Petitioner prevailed in that litigation and the term FASHION TELEVISION was declared generic in a final judgment entered on April 24, 2002. (Exhibits B, C).

Respondent did enter into an alleged trademark assignment agreement with Bell Media, Inc., (“Bell”) however, the subject agreement was back-dated and was not entered into until sometime in 2015. The assignment agreement was entered into following the commencement of litigation in the Southern District of New York by Petitioner stemming from certain cease-and-desist letters sent by Petitioner d/b/a/ Fashion Television International, Ltd. (“FTIL”). *F. TV Ltd. and Fashion TV Programmgesellschaft mbH v. Bell Media and Bigfoot Entertainment, Inc.*, 14 Civ. 9856 (KBF) (S.D.N.Y.) (the “Litigation”). A copy of the Litigation docket is annexed as Exhibit D. A copy of a subject cease-and-desist letter is annexed as Exhibit E. The Declaration of Kevin Assaff relied on in the Petition and proposed Amended Petition was filed in connection with the Litigation. (Doc. 1).<sup>1</sup>

While Respondent has claimed that FTIL authorized the cease-and-desist letters, discovery in connection with the Litigation provides that Bigfoot entered into the subject retainer agreement with counsel that drafted the letters and provided the relevant instructions. A copy of the retainer and relevant correspondence from Respondent’s former counsel are annexed as Exhibits F and G respectively. Respondent has also caused FTIL to file a complaint against Petitioner’s website before the WIPO. As more fully set forth below, Petitioner clearly has standing to prosecute this matter because it is a legitimate interest in the outcome of the

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<sup>1</sup> “Doc” references are to the Prosecution History documents numbers on the ttabvue website. <http://ttabvue.uspto.gov/ttabvue/v?pno=92061150&pty=CAN&eno=5>

proceeding in addition to reasonable apprehension of damages in light of the cease-and-desist letters sent by Petitioner.

## **ARGUMENT**

### **I. Legal Standard**

In order to withstand a motion to dismiss, FTV's pleading need only allege such facts as would, if proved, establish that (1) FTV has standing to maintain the proceeding, and (2) a valid ground exists for cancelling the subject registration. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (C.C.P.A. 1982). In this case, Respondent's motion is restricted to an allegation that Petitioner has failed to adequately allege standing. (Doc. No. 4). When ruling on a motion to dismiss for lack of standing, a reviewing court must accept as true all well-pled and material allegations of the petition and must construe the petition in favor of the complaining party. *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490, 492 (Fed. Cir. 1987).

### **II. Petitioner Has Established Standing In Its Pleading**

With respect to standing, Section 13 of the Lanham Act, 15 U.S.C. § 1063(a), provides, in relevant part:

Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor....

The United States Court of Appeals for the Federal Circuit addressed at length the standing requirements in *Ritchie v. Simpson*, 170 F.3d 1092, 1095-1099 (Fed. Cir. 1999). There, the Federal Circuit held that in order to establish standing, a petitioner must have a "real interest" in the outcome of the proceeding and have a "reasonable" belief of damage. *Id.* (citations omitted).

Under the “real interest” requirement, FTV must have “a legitimate personal interest in the opposition.” *Dalton v. Honda Motor Co.*, 425 F. App'x 886, 890 (Fed. Cir. 2011) *quoting Ritchie*, 170 F.3d at 1095. With respect to the second inquiry, FTV’s belief of damage “must have a reasonable basis in fact.” *Id. quoting Ritchie* at 1098. The foregoing tests are not exacting and are designed to prevent frivolous litigation. *First Data Merch. Servs. Corp. v. SecurityMetrics, Inc.*, No. CIV.A. RDB-12-2568, 2013 WL 6234598, at \*9 (D. Md. Nov. 13, 2013) *citing Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d at 1029.

Respondent’s motion to dismiss references the Litigation. (Doc. 4 at FN 1). Indeed, the declaration of Kevin. Assaff upon which this proceeding is based was submitted in connection with the Litigation. (Doc. 1). The Board may take judicial notice of the Litigation, including the documents annexed to this brief, pursuant to Fed. R. Evid. 201 and Petitioner hereby requests that it do so. (Exhibits D, E). In light of the claims made by Respondent against Petitioner in the cease-and-desist letters and before WIPO, it is clear that Petitioner has an interest in this proceeding and a reasonable apprehension of damages. Therefore, Respondent’s motion to dismiss must be denied.

### **III. Leave To File An Amended Petition Should Be Granted Pursuant To Fed. R. Civ. P. 15**

“[T]he Board freely grants leave to amend pleadings found, upon challenge under Fed.R.Civ.P. 12(b)(6), to be insufficient, particularly where the challenged pleading is the initial pleading.” *Miller Brewing Co.*, 27 U.S.P.Q.2d 1711 (P.T.O. June 2, 1993). Here, Petitioner has submitted a proposed amended pleading that details, among other things, the cease-and-desist letters underlying the Litigation. (Exhibits A, E). As set forth above, the cease-and-desist letters establish both that Petitioner has a “real interest” in this action because its right to broadcast its fashion-related content in the United States has been threatened. Similarly, Petitioner has a

“reasonable” expectation of incurring damages in light of the cease-and desist letters.

Accordingly, the Board should grant leave to file an Amended Petition. (Exhibit A).

**WHEREFORE**, Petitioner submits that Respondent’s motion to dismiss should be denied and that that the Board grants any such relief in favor of Petitioner that is deems just, proper or equitable.

Dated: New York, New York  
May 19, 2015

Respectfully submitted,

DUNNINGTON, BARTHOLOW & MILLER LLP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No. 2,945,407	§	
Mark: FT FASHION TELEVISION	§	
Issued: May 3, 2005	§	
	§	Cancellation No. 92061150
	§	
	§	Registration No. 2,945,407
FASHION TV Programmgesellschaft mbH,	§	
	§	
Petitioner	§	
	§	
v.	§	
	§	
Bigfoot Entertainment Inc.,	§	
	§	
Respondent	§	

**AMENDED PETITION FOR CANCELLATION**

FASHION TV Programmgesellschaft mbH (“Petitioner”), a limited liability company organized and existing under the laws of Austria, having its principal place of business at Wasagasse 4, A-1090 Wien, Austria, has been damaged by Service Registration No. 2,945,407 (the “Registration”) for the stylized service mark FT FASHION TELEVISION (the “Mark”), and hereby petitions to cancel the same under the provisions of Section 14 of the Lanham Act, 15 U.S.C. §1064(3) on the grounds that the Mark has been abandoned.

Petitioner has standing to bring the proceeding since it has a real interest in the Mark because it broadcasts fashion-related content in the United States since at least 1998 and the Mark is being actively used in attacks against Petitioner. Petitioner has been damaged and has a reasonable fear of suffering additional damage because, among other things, Bigfoot Entertainment Inc. (“Respondent”) claims an exclusive “brand” interest emanating from the

Mark giving is exclusivity in the mark FASHION TELEVISION which it is attempting to use towards eliminating Petitioner's business. Specifically, Respondent has (i) filed an action attacking Petitioner's domain name [www.fashiontv.com](http://www.fashiontv.com) claiming that it is confusingly similar to the Mark; and (ii) caused cease-and-desist letters to be sent to Petitioner and its distributors alleging that Petitioner's broadcasts are confusingly similar to the Mark, thus disrupting the marketplace and causing Petitioner to incur reputational and other damages.

In support of this Amended Petition for Cancellation, Petitioner relies on the Declaration of Kevin A. Assaff dated March 2, 2015 ("Assaff Decl.") submitted by Bell Media, Inc. in connection with an on-going litigation known as *F. TV Ltd. and Fashion TV Programmgesellschaft mbH v. Bell Media and Bigfoot Entertainment, Inc.*, 14 Civ. 9856 (KBF) (S.D.N.Y.) (the "Litigation"). The Litigation was commenced in response to Respondent's attacks against Petitioner. Mr. Assaff is the Senior Vice-President, Legal and Regulatory Affairs, for Bell, a former owner of the Registration. In making his declaration, Mr. Assaff was authorized by Bell Media to make statements on behalf of the company. *Assaff Decl.* ¶ 1. The Assaff Declaration with accompanying Exhibit A is attached hereto.

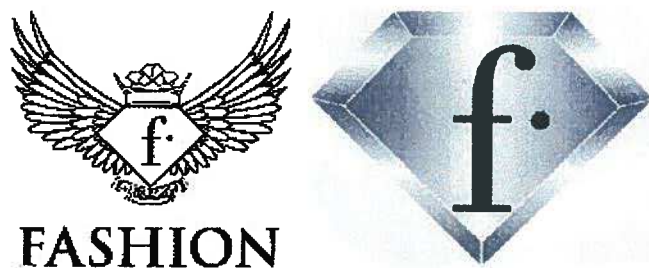
As grounds for cancellation, Petitioner asserts that:

**I. Petitioner's Business**

1. Petitioner has been broadcasting its content, consisting primarily of fashion related programming, in the United States since at least 1998.
2. Petitioner broadcasts its content on [www.fashiontv.com](http://www.fashiontv.com), [www.ftv.com](http://www.ftv.com) as well as on YouTube and through the DISH Network.
3. Petitioner owns several registered United States trademarks including those bearing Registration Numbers 4370506, 4420243, 4216146, 4184716, 3734435, 3689638 and



3530563. Copies of the relevant filings as received from the Trademark Electronic Search System (“TESS”) are annexed hereto as Exhibit B. Several of the marks owned by FTV feature an “f” enclosed in a diamond e.g. Registration Nos. 4370506 and 3689638 reproduced below.



## **II. The History Of Respondent’s Mark**

4. On May 9, 1996, CHUM, Ltd. (“Registrant”) submitted application serial no. 75,101,259 to the USPTO for the stylized Mark, with use claimed in International Classes 38 and 41. The application was submitted under Sections 1(a) (15 U.S.C. 1051(b)) and 44(d) (15 U.S.C. 1126(d)) of the Lanham Act. First use under Section 1(a) was claimed beginning 1992. Section 44(d) priority was claimed based upon Canadian application no. 810,139. *Assaff Decl. Exhibit A.*

5. The Mark is depicted below:



6. On May 3, 2005, the USPTO issued registration no. 2,945,407 for the Mark. *Assaff Decl. Exhibit A.*

7. In June 2007, Registrant was purchased by CTVglobemedia Inc. (“CTV”). Included in this purchase were rights to the Mark. *Assaff Decl. ¶ 5.*

8. In April 2011, CTV was purchased by BCE, Inc. (“BCE”). *Assaff Decl.* ¶ 6. Following this purchase, the Registration was assigned to BCE’s subsidiary, Bell Media Inc. (“Bell Media”). *Assaff Decl.* ¶ 2.

9. In October 2014, Bell Media licensed the Mark to Respondent.

10. In February 2015, an assignment of the Mark to Respondent from Bell Media was recorded with the U.S. Patent and Trademark Office.

### **III. Respondent’s Attack On Petitioner’s Business**

11. On or about December 5, 2014, Respondent sent cease-and-desist letters to Petitioner and its distributors demanding that Respondent terminate its broadcasts in the United States because they were confusingly similar to the Mark. A copy of a cease-and-desist letter is annexed as Exhibit C.

12. On or about March 26, 2015 Respondent, through a licensee of the Mark, had filed an action against Petitioner’s domain name [www.fashiontv.com](http://www.fashiontv.com) in the World Intellectual Property Organization claiming that it is confusingly similar the Mark.

13. Respondent’s attacks have caused Petitioner to suffer economic, reputational and other damages and continue to cause Petitioner a reasonable fear of future attacks.

### **IV. Respondent’s Mark Has Been Abandoned**

14. In April 2012, the FT Fashion Television Series, which had been broadcast on various cable channels in the US, was cancelled, and then-current owner Bell Media ceased use of the mark in the US. Specifically, Bell Media has not aired the FT Fashion Television Series in the US since April 2012, and never aired the FT Fashion Television Channel in the US, despite broadcasting in Canada from 2001 through the present. *Assaff Decl.* ¶¶ 11-12.

15. Bell Media abandoned the Mark with its final US use in April 2012. *Assaff Decl.* ¶ 21.

16. The Mark is not currently in use in the United States and has not been since April 2012.

17. The Registration should be cancelled because it has been abandoned.

18. According to Bell's legal counsel, Bell Media had no intent of resuming use when it ceased broadcast of programming utilizing the Mark in April 2012. *Assaff Decl.* ¶ 21.

19. As early as 2007, the owner of the Registration intended to abandon use of the mark outside Canada and accordingly began to unwind existing international licenses and syndication rights. *Assaff Decl.* ¶ 15.

20. Since 2007, owner CTV had a general policy of not opposing proceedings in foreign jurisdictions, including the US, which sought cancellation of the registrations if the FT Fashion Television marks (which include the Mark central to this petition) were no longer in active use in those jurisdictions. Mr. Assaff notes that CTV made only the efforts needed to maintain foreign trademark registrations. *Assaff Decl.* ¶ 21.

21. Bell Media followed CTV's precedent policy of allowing cancellation proceedings brought in foreign jurisdictions where trademarks were no longer actively used to proceed unopposed and doing only the minimum required to maintain foreign trademark registrations. *Assaff Decl.* ¶21.

22. This policy of what amounted to cancellation upon request is clear, unequivocal evidence that the owner of the Mark had no intention of resuming use of the Mark outside of Canada.

**WHEREFORE**, Petitioner prays that Registration No. 2,945,407 be cancelled pursuant to 15 U.S.C. §1064(3) because the FT FASHION TELEVISION trademark has been abandoned along with any such further relief the Board deems proper.

Dated: New York, New York  
May 19, 2015

Respectfully submitted,

DUNNINGTON, BARTHOLOW & MILLER LLP

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# EXHIBIT A

UNITED STATES DISTRICT COURT FOR THE  
SOUTHERN DISTRICT OF NEW YORK

F.TV Ltd., and FASHION TV  
PROGRAMMGESELLSCHAFT MbH,

Plaintiffs,

**V.**

**BELL MEDIA, INC.**, a Canadian Corporation,  
as successor-in-interest to **CHUM LIMITED**, a  
Canadian Corporation, and **BIGFOOT**  
**ENTERTAINMENT, INC.** d/b/a/ **FASHION**  
**TELEVISION INTERNATIONAL, LTD.**,

**Defendants.**

Civil Action No. 14-cv-9856 (KBF)

**DECLARATION OF KEVIN A. ASSAFF**

I, KEVIN A. ASSAFF, of the City of Toronto, in the Province of Ontario, pursuant to 28 U.S.C. § 1746, declare as follows:

1. I am the Senior Vice-President, Legal and Regulatory Affairs, for defendant Bell Media Inc. (hereinafter, “Bell Media”). I submit this declaration in support of Defendant’s Motion to Dismiss. I am authorized by Bell Media to make this statement on its behalf. Unless otherwise stated, the facts and matters referred to in this statement are within my personal knowledge, or are based on information gleaned from documents and records of Bell Media to which I have access, and are true to the best of my knowledge, information, and belief.

2. Bell Media is a Canadian corporation registered under the Canada Business Corporations Act, with a principal place of business at 299 Queen Street West, Toronto, Ontario M5V 2Z5. Bell Media is a wholly-owned subsidiary of Bell Canada, a Canadian corporation,

and Bell Canada is a wholly-owned subsidiary of BCE, Inc. (“BCE”), a publicly-traded company.

3. I have held my current position since April 2011. Prior to assuming this role, I held various positions in the business and legal affairs groups of CTVglobemedia Inc. (“CTV”), including Senior Vice-President and General Counsel. I began my career at BCE, where I served as Assistant General Counsel prior to joining CTV in 2002. I was called to the Ontario bar in 1994 and I am currently a member in good standing in that jurisdiction.

4. I submit this declaration to set forth relevant facts about (i) Bell Media, CHUM, Ltd. (“CHUM”), and CTV; (ii) Bell Media’s relationship with co-defendant Bigfoot Entertainment, Inc. (“Bigfoot”); and (iii) Bell Media’s interests in and transactions regarding the “FT Fashion Television” brand, trademarks and content.

**Background Regarding the Corporate Relationships  
between Bell Media, CHUM and CTV**

5. CHUM was a Canadian corporation that produced, broadcast and distributed television and radio programming. CTV is one of Canada’s national broadcast networks. In June 2007, CTV purchased all of the assets of CHUM for an estimated \$1.7 billion CAD. Included in this purchase were the trademark rights and content associated with the FT Fashion Television Series and Channel (as described below). Prior to CTV’s acquisition of CHUM in 2007, the two companies were entirely distinct corporate entities. Post-acquisition, CTV made significant changes, replacing CHUM’s then-existing management with CTV employees and implementing policies and procedures consistent with those of CTV. This transaction had no relationship with the State of New York.

6. Almost four years later, in April 2011, the Canadian Radio-television and Telecommunications Commission (“CRTC”) approved the purchase of all of CTV’s assets by its

minority shareholder, BCE. BCE is Canada's largest communications company and, through its subsidiaries, provides a comprehensive and innovative suite of broadband communications and content services to consumer, residential, business and government customers in Canada, including fiber-based IPTV and high-speed Internet services, 4G LTE wireless, home phone and business network and communications services.

7. Following BCE's purchase of CTV, Defendant Bell Media, Inc. was formed in 2011 to hold all of BCE's multimedia assets. Bell Media is now Canada's premier multimedia company, with assets that include radio broadcasting, digital media and internet properties, and television broadcasting and production, including CTV, Canada's #1 television network and the country's most-watched specialty channels. Among its many assets were the rights in the FT Fashion Television Series and Channel (as defined below). Bell Media's head office is situated in Toronto, Ontario, although production for its programs occurs across Canada and its content reaches Canadians across the country.

8. Neither the BCE transaction nor the incorporation of Bell Media had any relationship with the State of New York.

**Background Regarding "FT Fashion Television" Series, Channel and Brand and Bell Media's Acquisition of the Rights of FT Fashion Television**

9. Fashion Television, commonly referred to as 'FT,' launched in 1985 as a series of 15-minute clips on CityTV, a local Toronto station then operated by CHUM.

10. In 1986, the clips were expanded into an independent, half-hour broadcast (the "FT Fashion Television Series" or "Series"). As one of the first television series devoted to interviews and reporting on topics relevant to the fashion industry from haute couture to street fashion, the Series and its host, Jeanne Beker, rapidly gained in popularity. In addition to reporting on fashion events and trends, Beker introduced the world to Marc Jacobs (an unknown



at the time), and developed ongoing relationships with industry leaders like Donna Karan, Calvin Klein, the late Alexander McQueen, the iconic Karl Lagerfeld, supermodel Naomi Campbell, and many others—all of whom were featured on the Series. After an incredibly successful 27-year run, production for the final episode of the FT Fashion Television Series ended on April 11, 2012.

11. In 1992, on information and belief, the Series began to air in the United States on the VH1 cable channel. In 1998, the Series moved to E! Entertainment and its sister cable network, Style. To my knowledge, the Series has not aired in the United States, or more specifically New York, since the Series was cancelled in April 2012.

12. In or around September 2001, CHUM also launched the FashionTelevisionChannel, an English-language specialty television service dedicated to fashion, beauty, style, art, architecture, photography and design, which was broadcast nationwide in Canada (hereinafter, the “FT Fashion Television Channel” or “Channel”). The FT Fashion Television Channel continues to broadcast content in Canada. However, the Channel has never been broadcast in the United States.

**The FT Fashion Television Logo/Trademark**

13. As early as 1992, I understand that CHUM used the FT Fashion Television mark and logo (the “FT Fashion Television Logo”), depicted below, to identify the Series and later the FT Fashion Television Channel within Canada.



This trademark, and related trademarks, are the subject of numerous trademark registrations in Canada and internationally, including the United States (collectively, the “FT Fashion Television Marks”).

14. Based on the number of registrations and syndication licenses that were in CHUM’s portfolio when CTV acquired CHUM in 2007, it appeared that CHUM put great emphasis on international content licensing. Among other international contacts, CHUM filed trademark registrations in various FT Fashion Television Marks internationally and syndicated the FT Fashion Television Series to third-party broadcasters in Europe, the Pacific Rim and the United States for some period of time.

15. While CHUM had aspired to license and syndicate content internationally, after the acquisition and a change in management, CTV made the strategic decision to focus on the Canadian market. Accordingly, CTV began to unwind existing international licenses and syndication rights for the content acquired from CHUM.

16. Among the trademarks acquired by CTV (and, later, by Bell Media) is the United States registration for the FT Fashion Television Logo. Our records evidence that on May 3, 2005, the above FT Fashion Television Logo was registered by the United States Patent and Trademark Office as a service mark, U.S. S. Reg. No. 2,945,407, for use in connection with Classes IC 038, “broadcasting programs via a global computer network,” and IC 041, “production and distribution of television programs; and entertainment services in the nature of an ongoing series of television programs concerning commentary, news, history and personalities in the fields of fashion, design trends, photography, art, architecture, music, pop culture, and dance” (the “U.S. Registration”) (A copy of the U.S. Registration is attached as **Exhibit A.**)

17. The U.S. Registration for the FT Fashion Television Logo became incontestable on May 3, 2010, five years after registration. Bell Media has no records of Plaintiffs, or any other party, seeking to cancel the U.S. Registration.

18. Based on the various acquisitions described above, on April 1, 2011, the U.S. Registration was assigned from CTV to Bell Media and the assignment was subsequently recorded with the USPTO.

19. The FT Fashion Television Logo was consistently used in connection with syndicated television broadcasts of the FT Fashion Television Series internationally, including use in the United States beginning in 1992.

20. Bell Media continues to use the FT Fashion Television Logo in Canada in connection with its FT Fashion Television Channel, <http://www.bellmedia.ca/sales/tv/fashion-television/>, and the associated Canadian website, <http://www.fashiontelevision.ca>.

21. While CTV (and later Bell Media) made the efforts needed to maintain its foreign trademark registrations, it did not oppose any proceedings in foreign jurisdictions (including those initiated by Plaintiffs) which sought cancellation of the registrations if the FT Fashion Television Marks were no longer in active use in those jurisdictions.

**Bell Media's Operations in and Contacts with New York and the United States**

22. Bell Media's operations are centered in Canada—not in the United States or New York. It does not have any significant operations in the United States and none in New York and, as explained below, only a minute portion of its revenues are derived from the United States.

23. Bell Media does not derive more than minute revenues from licensing or syndicating any programs or series to entities in the United States, or more specifically, New York. To the extent that any Canadian programming that broadcasts on Bell Media's Canadian

networks is syndicated to networks or channels in the United States, those licensing and syndication relationships, in almost all instances, are negotiated by the third-party production companies that created the content. Bell Media does not obtain any revenues as a result of those relationships. On occasion, U.S. news programs have licensed excerpts of news footage from Bell Media's affiliates for a nominal fee (if any)—for example, in connection with the recent shooting of a member of the armed forces by an alleged terrorist in Canada's capital city, Ottawa. But these episodic licenses produce *de minimis* revenue for Bell Media.

24. Bell Media's only business operation in the United States concerns a wholly-owned subsidiary, Canadian Radio Sales, Inc. (of which I am a Director), that sells Canadian radio airtime to businesses in Detroit seeking to reach customers across the Canadian border, in the vicinity of Windsor, Ontario. Beyond this subsidiary, Bell Media does not have any operations in the United States and does not generate revenues by marketing content or services to U.S. consumers. To the extent that any of Bell Media's expenses are attributable to the United States, these include costs incurred in connection with limited news reporting in the United States or costs incurred when licensing content to be aired on Bell Media stations in Canada from creators/owners in the United States, such as programming and related trademarks. To the extent that any of Bell Media's revenues are attributable to the United States, these involve minimal revenues generated when U.S. entities purchase airtime through agencies in order to advertise their products or services to Canadian consumers on Bell Media's Canadian television and radio stations. However when Bell Media acquires content from the United States to air in Canada, or when companies purchase advertising on Bell Media's Canadian stations, Bell Media does not receive any revenue from the sale or exploitation of services or goods in the United States. None

of these business arrangements have anything to do with the FT Fashion Television Marks or Logo, including the U.S. Registration for the Logo.

25. Bell Media does not have any other contacts with the State of New York. It is not registered to do business in New York State with the New York Secretary of State. It has no offices, employees, sales representatives, bank accounts or other property or assets in New York. With the exception of this action, it is not involved in any other active litigation in New York. In connection with its prior relationship with the NHL, Bell Media had an insignificant interest in a limited partnership in the U.S. version of the NHL Network based in New York, as well as an interest in the NHL Network in Canada. Bell Media's interest in that NHL Network partnership has been sold.

26. Since BCE acquired CTV's assets in 2011, Bell Media has not acted in any fashion to ratify CHUM's prior contacts with the United States District Court for the Southern District of New York; it has never done anything to rely on the CHUM decisions; and, it has not initiated any follow-up litigation to the CHUM action in New York.

**Bell Media's Contacts with Bigfoot/Fashion Television International, Ltd. ("FTIL")**

27. In 2014, Bigfoot's Managing Partner, Michael Gleissner, contacted Bell Media seeking to purchase Bell Media's rights in the FT Fashion Television brand and FT Fashion Television Marks, in all regions except Canada. At that time, Bell Media's use of FT Fashion Television was limited to the Canadian market and Bell Media was not using the FT Fashion Television Marks outside of Canada, including in the United States.

28. It was my understanding that Bigfoot was interested in achieving deeper market penetration for its own fashion-related content in certain countries in Europe and Asia. Knowing that Bell Media had an established brand and registered trademarks in some of these countries, Bigfoot was interested in acquiring those rights from Bell Media.

29. Bell Media's negotiations with Bigfoot took place entirely by telephone and over email, with Mr. Gleissner as the primary contact for Bigfoot and myself as the primary contact for Bell Media. I was in Canada, and it is my understanding that Mr. Gleissner was located in Singapore or Hong Kong throughout the negotiations. According to the Agreement ultimately entered into, I understood that Bigfoot was a California corporation. While I am aware that Bigfoot's letterhead lists a New York address, I had no meetings in New York with Bigfoot in connection with the negotiation of the license agreement with Bigfoot or after its execution.

**A. The October 2014 Agreement**

30. Bell Media and Bigfoot ultimately executed an agreement in October 2014 (the "October 2014 Agreement"). Under the October 2014 Agreement, Bell Media licensed to Bigfoot the rights to 32 registered trademarks in 20 countries or regions for worldwide use with the exception of Canada. This included the U.S. Registration listed as Registration No. 2,945,407 in International Classes 038 and 041. A true and correct copy of the October 2014 Agreement is annexed hereto as **Exhibit B**. The October 2014 Agreement provided that Bigfoot would establish an entity using the brand "Fashion Television."

31. For accounting reasons, the parties agreed to a springing sale whereby Bigfoot would hold an exclusive license in the FT Fashion Television Marks outside of Canada, with an option to purchase the FT Fashion Television Marks at the end of four years.

32. Bell Media and Bigfoot agreed that the FT Fashion Television Marks were offered "as-is" with no representations or warranties by Bell Media, knowing that there were then-pending cancellation proceedings in the EU with respect to certain of the FT Fashion Television Marks. This understanding was clearly set forth in the October 2014 Agreement.

33. Bigfoot and Bell Media agreed upon a Canadian choice-of-law clause for the license agreement.

34. Pursuant to the October 2014 Agreement, Bell Media received no ongoing royalties attributable to Bigfoot's use of the FT Fashion Television Marks. The Agreement instead provided for a lump sum payment over four years. In other words, Bigfoot's decisions on how or where to use the marks had no bearing on Bell Media's earnings under the license.

35. Bigfoot and Bell Media also agreed to "geogate" the Fashion Television website so that access to Bell Media's content was limited to consumers within Canada, whereas Bigfoot's Fashion One content would be served to consumers from other regions.

36. Under the October 2014 Agreement, Bigfoot was "entitled to defend current brand assets such as trademarks." There were no discussions with Bigfoot concerning affirmative enforcement actions anywhere, including the United States. Instead, the October 2014 Agreement explicitly provided that any actions taken by Bigfoot to defend the FT Fashion Television Marks were to be taken at Bigfoot's "sole discretion and expense."

37. Bell Media had no contractual or other right or ability to control Bigfoot's attempts (or later those of its subsidiary FTIL) to defend the FT Fashion Television Marks under the October 2014 Agreement. The October 2014 Agreement did not include any restrictions on Bigfoot's defense of the FT Fashion Television Marks that required ongoing oversight by Bell Media or ongoing reporting by Bigfoot. Bell Media agreed only to provide whatever written assurances Bigfoot might need to authenticate the existence of the October 2014 Agreement and/or approve a sublicense of any of the FT Fashion Television Marks. For example, Bell Media was asked to confirm, in two letters dated November 26, 2014, that Bigfoot was Bell Media's licensee and that FTIL was Bigfoot's sublicensee. True and correct copies of the November 26, 2014 letters are annexed hereto as **Exhibit C**.

38. From the date the October 2014 Agreement was executed, Bell Media never exercised any control over, or played any role in, any enforcement or other actions taken by Bigfoot or FTIL with respect to the FT Fashion Television Marks.

39. Bigfoot further agreed to indemnify Bell Media with respect to any claims arising out of the October 2014 Agreement.

40. Based on our review of the Amended Complaint, it is Bell Media's understanding that Plaintiffs' claims arise out of cease-and-desist letters that FTIL sent to Atlantic Broadband in Massachusetts and F.TV in Austria. (*See* Am. Compl. Exs. G and N.)

41. Neither Bigfoot nor FTIL informed or consulted with Bell Media about its intentions with respect to the Plaintiffs. Bell Media had no knowledge that Bigfoot or FTIL or their representatives intended to send, or in fact had sent, the cease and desist letters described in the Amended Complaint until Bell Media was served with the Complaint in this action. Since the filing of this action, the management of both Bigfoot and FTIL provided Bell Media with letters confirming these facts. (Copies of the letters are annexed hereto as **Exhibits D and E.**)

42. Even now, Bell Media has no knowledge of any enforcement actions by Bigfoot or FTIL beyond those that Plaintiffs have alleged in the Complaint or that Plaintiffs have otherwise communicated to Bell Media since this action was filed.

**B. The December 2014 Assignment**

43. As the October 2014 Agreement indicates, it was the intent of the parties to ultimately sell and assign the FT Fashion Television Marks to Bigfoot. After the commencement of this action, the parties proceeded to consummate the anticipated sale and assignment of the Marks. Thus, Bell Media and Bigfoot executed a further agreement (the "Assignment"), effective December 24, 2014, pursuant to which Bell Media and Bigfoot agreed to terminate the October 2014 Agreement and Bell Media agreed to sell, assign and transfer to Bigfoot the FT



Fashion Television Marks and all of its worldwide rights, title and interest therein, except for Canada. A short-form assignment memorializing the transfer of ownership of the U.S. FT Fashion Television Mark is annexed hereto as **Exhibit F**. With the permission of Bigfoot, Bell Media will produce the Assignment Agreement in its entirety.

44. In short, Bell Media no longer has any ownership interest in the trademarks that are the subject of Plaintiffs' declaratory judgment claims.

I declare under penalty of perjury under the laws of Canada and the United States of America that the foregoing is true and correct to the best of my knowledge, information and belief.

Executed on March 2, 2015 in Toronto, Ontario, Canada.



Kevin A. Assaff

**EXHIBIT A**

**Int. Cls.: 38 and 41**

**Prior U.S. Cls.: 100, 101, 104 and 107**

**United States Patent and Trademark Office**

**Reg. No. 2,945,407**

**Registered May 3, 2005**

**SERVICE MARK  
PRINCIPAL REGISTER**



**FASHION  
TELEVISION**

CHUM LIMITED (CANADA CORPORATION)  
1331 YONGE STREET  
TORONTO, ONTARIO, M4T 1Y1, CANADA

FOR: BROADCASTING PROGRAMS VIA A GLOBAL COMPUTER NETWORK, IN CLASS 38 (U.S. CLS. 100, 101 AND 104).

FIRST USE 0-0-1992; IN COMMERCE 0-0-1992.

FOR: PRODUCTION AND DISTRIBUTION OF TELEVISION PROGRAMS; AND ENTERTAINMENT SERVICES IN THE NATURE OF AN ONGOING SERIES OF TELEVISION PROGRAMS CONCERNING COMMENTARY, NEWS, HISTORY AND PERSONALITIES IN THE FIELDS OF FASHION, DESIGN TRENDS, PHOTOGRAPHY, ART, ARCHITECTURE, MUSIC, POP CULTURE, AND DANCE, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 0-0-1992; IN COMMERCE 0-0-1992.

PRIORITY CLAIMED UNDER SEC. 44(D) ON CANADA APPLICATION NO. 810,139, FILED 4-17-1996.

OWNER OF U.S. REG. NO. 1,526,138.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TELEVISION", APART FROM THE MARK AS SHOWN.

SEC. 2(F).

SER. NO. 75-101,259, FILED 5-9-1996.

JOHN E. MICHOS, EXAMINING ATTORNEY

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# EXHIBIT B



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## FASHION

**Word Mark**

F F F. I LOVE FASHION

**Goods and Services**

IC 003. US 001 004 006 050 051 052. G &amp; S: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; perfumes

IC 032. US 045 046 048. G &amp; S: Beers; mineral and aerated waters; fruit drinks and fruit juices; syrups for making beverages; multivitamin juices; non-alcoholic energy drinks and isotonic drinks; non-alcoholic refreshing drinks in the nature of soft drinks

IC 033. US 047 049. G &amp; S: Alcoholic beverages except beers

IC 034. US 002 008 009 017. G &amp; S: Tobacco, whether manufactured or unmanufactured; tobacco substitutes, none being for medicinal or curative purposes; cigarettes; cigarillos; cigars; hand-held machines for making cigarettes; hand-held machines for rolling cigarettes; cigarette tubes; cigarette filters; cigarette papers; matches; lighters for smokers

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Search Code**

03.17.01 - Wings, birds'

20.03.02 - Foil, aluminum (rolls); Gift wrapping paper (rolls); Paper towels (rolls); Paper, gift wrapping (rolls); Paper, rolls; Paper, toilet; Scrolls; Toilet paper; Towels, rolls of paper towels; Wallpaper, rolled

24.11.02 - Crowns open at the top

26.07.01 - Diamonds with plain multiple line border; Diamonds with plain single line border

**Serial Number**

79118586

**Filing Date**

July 30, 2012

**Current Basis**

66A

**Original Filing Basis**

66A

**Published for Opposition**

May 7, 2013

**Registration Number**4370506  
1130911

**International  
Registration  
Number****Registration  
Date**

July 23, 2013

**Owner**(REGISTRANT) FASHIONTV.COM GmbH GmbH (Limited liability company) FED REP GERMANY  
Brienner Strasse 21 80333 München FED REP GERMANY**Priority Date**

February 9, 2012

**Prior  
Registrations**

3130117;3689638;AND OTHERS

**Description of  
Mark**

Color is not claimed as a feature of the mark. The mark consists of a crown containing three (3) diamond-shaped symbols, with the lower-case letter "F" and a small circle adjoining it in the middle symbol. This crown sits upon a banner, which is directly above another large diamond-shaped symbol also containing the lower-case letter "F" followed by a small circle within it. Below the large diamond are two banners, one of which contains the wording "I LOVE FASHION". To the left and right side of the large diamond are a set of feathered wings that arch upwards. Beneath all of the above is the word "FASHION".

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Live/Dead  
Indicator**

LIVE

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**Word Mark**  
**Goods and Services**

LOVE F CAFÉ

IC 021. US 002 013 023 029 030 033 040 050. G & S: Household and kitchen utensils, namely, graters, sieves, spatulas, strainers, turners, pot and pan scrapers, rolling pins, whisks, skimmers, kitchen tongs, splatter screens, pouring and straining spouts; household and kitchen containers; combs and bath sponges, body sponges, facial sponges for applying make-up, cleaning sponges and metal sponges for household purposes; brushes except paint brushes, namely, dusting brushes, floor brushes, hair brushes, scrubbing brushes; brush-making materials, articles for cleaning purposes, namely, cleaning cloths, cleaning sponges; steel wool; unworked or semi-worked glass except glass used in building; glassware, porcelain and earthenware not included in other classes, namely, bottles sold empty, beverage glassware, porcelain figures, earthenware figures

IC 025. US 022 039. G & S: Clothing, namely, shirts, pants, coats, dresses; footwear, headgear, namely, hats, caps; belts

IC 030. US 046. G & S: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, namely, breakfast cereals; bread, pastry and confectionery, namely, confectionery made from sugar, frozen confectionery; chocolate and chocolate articles, namely, chocolate bars, chocolate candies, chocolate chips, chocolate confections; ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar; condiments, namely, sauces; spices; ice

IC 043. US 100 101. G & S: Services for providing food and drink, namely, restaurants, providing food and drink, cafes, catering services; temporary accommodation, namely, arranging and providing temporary housing accommodations, rental of rooms as temporary living accommodations, hotel services, motel services; services of a cafe, namely, cafe services, catering services

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Search Code**

26.01.21 - Circles that are totally or partially shaded.

26.11.21 - Rectangles that are completely or partially shaded

26.15.01 - Polygons as carriers or as single or multiple line borders

**Serial Number** 79113374**Filing Date** March 22, 2012**Current Basis** 66A

**Original Filing Basis** 66A

**Published for Opposition** August 6, 2013

**Registration Number** 4420243

**International Registration Number** 1117329

**Registration Date** October 22, 2013

**Owner** (REGISTRANT) fashiontv.com GmbH GmbH (Limited Liability Company) FED REP GERMANY Briener Strasse 21 80333 München FED REP GERMANY

**Priority Date** September 23, 2011

**Prior Registrations** 2985587;3130117;3689638;AND OTHERS

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CAFE" FOR CLASSES 30 AND 43 APART FROM THE MARK AS SHOWN

**Description of Mark** Color is not claimed as a feature of the mark. The mark consists of a rectangle containing the wording "LOVE F CAFÉ" where there is a polygon around the letter "F" with a circle to the right of the letter "F" inside of the polygon.

**Type of Mark** TRADEMARK. SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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# I love ashion

**Word Mark**

I LOVE FASHION

**Goods and Services**

IC 018. US 001 002 003 022 041. G & S: Leather and imitations of leather; leather goods, namely, animal skins and hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; bags, namely, backpacks, rucksacks, knapsacks, all-purpose sport bags, luggage, tote bags, shoulder bags, duffel bags, day packs, wallets, purses

IC 025. US 022 039. G & S: Clothing and headgear, namely, hats, caps, shirts, t-shirts, tank tops, knit tops, woven tops, halter tops, sweatshirts, sweatpants, jogging pants, swimwear, underwear, boxer shorts, bras, panties, hosiery, socks, pants, short pants, jeans, dresses, skirts, belts, sweaters, vests, gloves, coats, jackets and scarves; footwear

IC 035. US 100 101 102. G & S: Business franchising consultation services, namely, business and organizational consulting for franchise concepts; business management for third parties for franchise companies; retail store services in the field of bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices; retail store services in the field of scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire-extinguishing apparatus; retail store services in the field of precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, horological and chronometric instruments; retail store services in the field of paper, cardboard and goods made from these materials, printed matter, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites, instructional and teaching material, plastic materials for packaging, printers' type, printing blocks; retail store services for furniture, mirrors, picture frames, goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics. retail store services in the fields of household or kitchen utensils and containers, combs and sponges, brushes, brush-making materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass except glass used in building, glassware, porcelain and earthenware; retail store services in the fields of clothing, footwear, headgear; retail store services in the fields of meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats; retail store services for coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces, spices, ice; retail store services in the field of beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages; retail store services in the field of alcoholic

beverages; Advertising; business management; business administration; office functions; business management for franchise companies; business and organizational franchise consultancy services

**Mark Drawing Code** (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Search Code** 26.15.01 - Polygons as carriers or as single or multiple line borders

**Serial Number** 79110481

**Filing Date** November 9, 2011

**Current Basis** 66A

**Original Filing Basis** 66A

**Published for Opposition** July 17, 2012

**Registration Number** 4216146

**International Registration Number** 1110261

**Registration Date** October 2, 2012

**Owner** (REGISTRANT) FASHIONTV.COM GmbH LIMITED LIABILITY COMPANY FED REP GERMANY Briener Strasse 21 80333 München FED REP GERMANY

**Priority Date** May 12, 2011

**Prior Registrations** 3130117;3734435;3737076;AND OTHERS

**Description of Mark** Color is not claimed as a feature of the mark. The mark consists of the stylized wording "I LOVE FASHION" with the letter "F" in fashion and a dot appearing inside a pentagon.

**Type of Mark** TRADEMARK. SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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**Word Mark** FFF MICHEL ADAM F I LOVE FASHION

**Goods and Services** IC 032. US 045 046 048. G & S: Mineral and aerated waters; fruit drinks and fruit juices; concentrates, syrups or powders use in the preparation of soft drinks

IC 033. US 047 049. G & S: Alcoholic beverages, namely, vodka

IC 041. US 100 101 107. G & S: Film production, motion picture rental; Entertainment, namely, on-going fashion, variety, news, reality shows broadcast over television, satellite, audio, and video media; Entertainment, namely, production of television shows, award shows, films, concerts, fashion shows. Entertainment services in the nature of presenting musical performances featuring singing, theatre and dancing performances, live and via media; production of radio and TV programs; Organizing cultural events; Entertainment in the nature of live stage performances in the nature of concerts and fashion shows, or lecture for hire in the field of fashion and entertainment by an individual; film distribution for movies stored on videos, CDs, CD-ROMS and DVDs, organization of award shows; organization of fashion shows for entertainment purposes

**Mark Drawing Code** (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Search Code** 03.17.01 - Wings, birds'  
 24.09.07 - Advertising, banners; Banners  
 24.11.02 - Crowns open at the top  
 26.01.21 - Circles that are totally or partially shaded.  
 26.01.30 - Circles, exactly four circles; Four circles  
 26.07.01 - Diamonds with plain multiple line border; Diamonds with plain single line border

**Serial Number** 79091595

**Filing Date** November 10, 2010

**Current Basis** 66A

**Original Filing Basis** 66A

**Published for Opposition** May 22, 2012

**Registration Number** 4184716

**International Registration Number** 1062415

**Registration Date** August 7, 2012

**Owner** (REGISTRANT) FASHIONTV.COM GmbH GmbH (limited liability company) FED REP GERMANY Brienner Strasse 21 80333 München FED REP GERMANY

**Attorney of Record** RAYMOND DOWD

**Prior Registrations** 2985587;3130117;3734435;AND OTHERS

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SINCE 1950" APART FROM THE MARK AS SHOWN

**Description of Mark** Color is not claimed as a feature of the mark. The mark consists of the wording "F·F·F· MICHEL ADAM F· I LOVE FASHION SINCE 1950", displayed across three (3) banners. The mark contains a crown containing three (3) diamond-shaped symbols embedded with the lower-case letter "F" followed by a circle within each diamond. This crown sits upon the first banner, which contains the wording "MICHEL ADAM". This banner is directly above another large diamond-shaped symbol also containing the lower-case letter "F" followed by a circle within it. Below the large diamond are two banners, one of which contains the wording "I LOVE FASHION" and another below it which contains the wording "SINCE 1950". To the left and right side of the large diamond are a set of feathered wings that arch upwards.

**Type of Mark** TRADEMARK. SERVICE MARK

**Register** PRINCIPAL

**Other Data** The name(s), portrait(s), and/or signature(s) shown in the mark identifies "MICHEL ADAM", whose consent (s) to register is made of record.

**Live/Dead Indicator** LIVE

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**f shop**

**Word Mark**

F SHOP

**Goods and Services**

IC 035. US 100 101 102. G & S: Retail store services in the fields of bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices; retail store services in the fields of scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire-extinguishing apparatus; retail store services in the fields of precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, horological and chronometric instruments; retail store services in the fields of paper, cardboard and goods made from these materials, printed matter, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites except furniture, instructional and teaching material except apparatus, plastic materials for packaging, printers' type, printing blocks; retail store services for furniture, mirrors, picture frames, goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics. retail store services in the fields of household or kitchen utensils and containers, combs and sponges, brushes except paint brushes, brush-making materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass except glass used in building, glassware, porcelain and earthenware; retail store services in the fields of clothing, footwear, headgear; retail store services in the fields of meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats; retail store services in the fields of coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, condiments in the nature of sauces, spices, ice; retail store services in the fields of beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages; retail store services in the fields of alcoholic beverages

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Search Code**

26.15.21 - Polygons that are completely or partially shaded



**Trademark Search Facility Classification Code** LETS-1 FF A single letter, multiples of a single letter or in combination with a design  
NOTATION-SYMBOLS Notation Symbols such as Non-Latin characters,punctuation and mathematical signs,zodiac signs,prescription marks  
SHAPES-CIRCLE Circle figures or designs including semi-circles and incomplete circles  
SHAPES-GEOMETRIC Geometric figures and solids including squares, rectangles, quadrilaterals and polygons  
SHAPES-MISC Miscellaneous shaped designs

**Serial Number** 79064446

**Filing Date** October 10, 2008

**Current Basis** 66A

**Original Filing Basis** 66A

**Published for Opposition** October 20, 2009

**Registration Number** 3734435

**International Registration Number** 0990964

**Registration Date** January 5, 2010

**Owner** (REGISTRANT) fashiontv.com GmbH GmbH (limited liability company) FED REP GERMANY Briener Strasse 21 80333 München FED REP GERMANY

**Priority Date** April 10, 2008

**Prior Registrations** 2985587;3130117

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SHOP" APART FROM THE MARK AS SHOWN

**Description of Mark** Color is not claimed as a feature of the mark. The mark consists of the stylized letter "F" and a shaded circular design element located to the right of the stylized letter "F", both appearing within a shaded polygon design. In addition, the stylized wording "F SHOP" appears just below the shaded polygon design.

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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<b>Word Mark</b>	F.
<b>Goods and Services</b>	IC 003. US 001 004 006 050 051 052. G & S: Bleaching preparations for household use or cosmetic purposes and other substance for laundry use, namely, laundry bleach; cleaning, polishing, scouring and abrasive preparations; soaps for household use or personal use; perfumery, essential oils, cosmetics, hair lotions; dentifrices
<b>Mark Drawing Code</b>	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
<b>Design Search Code</b>	17.03.01 - Diamonds, jewelry; Nuggets of precious metals; Stones, gems
<b>Trademark Search Facility Classification Code</b>	ART-17.03 Jewelry LETS-1 F A single letter, multiples of a single letter or in combination with a design SHAPES-CIRCLE Circle figures or designs including semi-circles and incomplete circles
<b>Serial Number</b>	79062103
<b>Filing Date</b>	October 8, 2008
<b>Current Basis</b>	66A
<b>Original Filing Basis</b>	66A
<b>Published for Opposition</b>	July 14, 2009
<b>Registration Number</b>	3689638
<b>International Registration Number</b>	0985009
<b>Registration Date</b>	September 29, 2009
<b>Owner</b>	(REGISTRANT) fashiontv.com GmbH GmbH (limited liability company) FED REP GERMANY Brienner Strasse 21 80333 München FED REP GERMANY
<b>Priority Date</b>	May 29, 2008

<b>Description of Mark</b>	Color is not claimed as a feature of the mark. The mark consists of the letter "F" with a small circle inside a stylized representation of a diamond.
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL
<b>Live/Dead Indicator</b>	LIVE

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FTV

<b>Word Mark</b>	FTV
<b>Goods and Services</b>	IC 038. US 100 101 104. G & S: cable and satellite television broadcasting services. FIRST USE: 19970101. FIRST USE IN COMMERCE: 19970101
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Trademark Search Facility Classification Code</b>	LETTER-3-OR-MORE FTV Combination of three or more letters as part of the mark
<b>Serial Number</b>	78656145
<b>Filing Date</b>	June 22, 2005
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	August 12, 2008
<b>Registration Number</b>	<b>3524211</b>
<b>Registration Date</b>	October 28, 2008
<b>Owner</b>	(REGISTRANT) Fashion TV Ltd. CORPORATION BR.VIRGIN ISLANDS P.O. Box 31149 Road Town Tortola BR.VIRGIN ISLANDS  (LAST LISTED OWNER) FASHIONTV.COM GMBH LIMITED LIABILITY COMPANY BRIENNER STRASSE 21 D 80333 MUNCHEN FED REP GERMANY
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED

<b>Attorney of Record</b>	Raymond J. Dowd
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL
<b>Affidavit Text</b>	SECT 8 (6-YR).
<b>Live/Dead Indicator</b>	LIVE

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# fashiontv

<b>Word Mark</b>	FASHIONTV
<b>Goods and Services</b>	IC 035. US 100 101 102. G & S: On-line retail store services featuring Fashion related products, namely, CDs, DVDs, Books, Magazines, Men's Wear, Women's Wear, Calendars, Beauty Products, Jewelry, Accessories, Handbags, Houseware, Plates, Cups, Dishes, and Tickets to special events. FIRST USE: 19971212. FIRST USE IN COMMERCE: 19971212
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Trademark Search Facility Classification Code</b>	LETS-2 TV Two letters or combinations of multiples of two letters
<b>Serial Number</b>	77437945
<b>Filing Date</b>	April 2, 2008
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	August 26, 2008
<b>Registration Number</b>	3530563
<b>Registration Date</b>	November 11, 2008
<b>Owner</b>	(REGISTRANT) FASHIONTV.COM GmbH CORPORATION FED REP GERMANY Promenadeplatz 9 Munich FED REP GERMANY 80333
<b>Attorney of Record</b>	Raymond J Dowd
<b>Type of Mark</b>	SERVICE MARK

**Register** PRINCIPAL  
**Affidavit Text** SECT 8 (6-YR).  
**Live/Dead Indicator** LIVE

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# EXHIBIT C

# FROSS ZELNICK LEHRMAN & ZISSU, P.C.

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 Stephen Bigger  
 Roger L. Zissu  
 Richard Z. Lehv  
 David Ehrlich  
 Susan Upton Douglass  
 Janet L. Hoffman  
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 Lawrence Eli Apolzon  
 Barbara A. Solomon  
 Mark D. Engelmann  
 Nadine H. Jacobson  
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 Allison Strickland Ricketts

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 Lydia T. Gobena  
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 Jennifer Insley-Pruitt  
 Emily Weiss  
 Ashford Tucker  
 Jessica Meiselman  
 Erica Gould  
 Matthew Frisbee  
 Celadon Whitehurst  
 Stacy L. Wu  
 Hindy Dym  
 Katherine Lyon Dayton  
 Maritza C. Schaeffer  
 Jeffrey D. Larson\*

December 5, 2014

## BY FEDEX

FASHION TV Programmgesellschaft mbH  
 Wasagasse 4  
 Wien, A-1090  
 AUSTRIA

Re: Infringement of FASHION TELEVISION Mark (Our Ref.: BIGF 1409881)

## To Whom It May Concern:

We represent Fashion International Television Ltd., a leading provider of high-quality programming relating to the world of fashion. Under a license emanating from Bell Media Inc. ("Bell Media"), our client has the right to use the FASHION TELEVISION mark and the FT FASHION TELEVISION (and design) mark in the United States and numerous other jurisdictions throughout the world. The licensed rights include, without limitation, the right to use and enforce rights in Bell Media's incontestable registered FT FASHION TELEVISION (and design) mark (U.S. Reg. No. 2,945,407) in connection with "broadcasting programs via a global computer network" and "production and distribution of television programs; and entertainment services in the nature of an ongoing series of television programs concerning commentary, news, history and personalities in the fields of fashion, design trends, photography, art, architecture, music, pop culture, and dance." The registration has a priority date of April 17, 1996 and is based on first use of the mark in commerce in connection with the identified services at least as early as 1992.

It has come to our client's attention that your company has launched a television network in the United States under the mark FASHION TV nationwide on the Dish Network and in parts of Florida on Atlantic Broadband cable. Moreover, our client has become aware that you are distributing fashion-related programming under the FASHION TV name and mark to consumers in the United States through various other media, including via the internet. Your company's use of a mark that is highly similar to the FASHION TELEVISION and FT FASHION TELEVISION (and design) marks for identical or closely related services to our client's services under those marks constitutes trademark infringement and unfair competition under Sections 32(1) and 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1), 1125(a), and various state laws.

In light of the foregoing, we demand that by **December 12, 2014**, your company immediately stop using the FASHION TV name and mark, or any other colorable imitation of the FASHION TELEVISION and FT FASHION TELEVISION (and design) marks, in connection with any television network or any television or internet programming and related services in the United States.

(F1590666 1 )

FASHION TV Programmgesellschaft mbH  
December 5, 2014  
Page 2

We trust that your company will take all action necessary to prevent further infringement of the FASHION TELEVISION and FT FASHION TELEVISION marks. If your company fails to do so, our client will not hesitate to take any action it deems necessary to protect its rights.

This letter is without waiver of or prejudice to any of our client's rights, claims and remedies, all of which are expressly reserved.

Very truly yours,

A handwritten signature in black ink that reads "David Donahue" followed by a stylized flourish or set of initials.

David Donahue

Cc : Raymond Dowd, Esq. (by FedEx)<sup>1</sup>

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<sup>1</sup> We are sending a copy of this correspondence to Mr. Dowd as a courtesy because we are aware that he has represented your company in relation to certain U.S. trademark matters, albeit concerning a different mark in a different context.

Not Reported in F.Supp.2d, 2001 WL 243541 (S.D.N.Y.), 2001-1 Trade Cases P 73,275  
(Cite as: **2001 WL 243541 (S.D.N.Y.)**)

**H**

United States District Court, S.D. New York.

**CHUM LIMITED**, a Canadian Corporation, Plaintiff,  
v.

Adam **LISOWSKI**, an Individual a/k/a Michel Adam and a/k/a Michel Adam **Lisowski** and d/b/a Fashion TV, Opera Holding Ltd., a French Corporation d/b/a Fashion TV and d/b/a F.TV, Fashion TV Paris, S.A.R.L., a French Limited Liability Company d/b/a F.TV Et F.L'Original Et F.International, Fashion TV NY, Inc., a New York Corporation, and Fashion TV, Ltd., a British Virgin Islands Corporation Defendants.

No. 98 CIV. 5060(KMW).

March 12, 2001.

#### ORDER

**WOOD**, D.J.

\*1 This suit arises out of a dispute over the rights to the name “fashion television.” Plaintiff, a Canadian entertainment company, sues for trademark infringement and dilution under the Lanham Act, trademark infringement and unfair competition under common law, and unfair business practices and trademark dilution under New York state law. Defendants, producers of a television channel focusing on fashion, have counterclaimed under the Sherman Act and the Lanham Act. Before the Court at this time are plaintiff's motions to dismiss and for summary judgment on defendants' counterclaims; <sup>FN1</sup> defendants' motion for summary judgment dismissing plaintiff's “trademark dilution and infringement claims” (Defendants' Memorandum of Support of Motion for Summary Judgment, dated February 28, 2000 [“Defts.' Mem.”] p. 1.); <sup>FN2</sup> defendants' motion for reconsideration of this Court's decision denying defendants leave to amend their Answer and Counterclaims; and the parties' motions for sanctions under

Federal Rule of Civil Procedure [“Fed.R.Civ.P.”] 11 [“Rule 11”]. For the reasons outlined below, the Court denies in part and grants in part defendants' request for reconsideration of this Court's Order denying leave to amend its answer and counterclaims, grants summary judgment on defendants' counterclaims, grants summary judgment on plaintiff's trademark infringement and trademark dilution claims, denies summary judgment on plaintiff's unfair competition claim, and denies the parties' motions for sanctions.

**FN1.** Plaintiff has reserved its right to seek a default judgment against Fashion TV NY, which it served on the New York Secretary of State, and which has not responded in this matter.

**FN2.** Defendants ignore, for purposes of this motion, plaintiff's third cause of action, which seeks relief for unfair business practices under [New York General Business Law § 349](#); they neither mention this claim in their briefs nor cite any decisions that discuss this statute. As a result, defendants have not met their burden of showing they are entitled to judgment on this claim as a matter of law.

#### I. BACKGROUND

##### *A. Plaintiff and its Program*

Plaintiff produces, broadcasts, and distributes television and radio programming. (Plaintiff's Rule 56.1 Statement of Material Undisputed Facts, dated March 3, 2000 [“Pl.'s 56 Statement”] ¶ 1.) One of plaintiff's productions is its magazine-format fashion program [“Program”], which features a host, interviews with photographers, designers, and models, and edited clips of fashion footage. (Defts.' Mem. p. 5.) Plaintiff calls this program “Fashion Television” but also uses “FT FashionTelevision,” “Fashion TV,” and “FTV” [hereinafter the “FT Marks”] in conjunction



Not Reported in F.Supp.2d, 2001 WL 243541 (S.D.N.Y.), 2001-1 Trade Cases P 73,275  
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with this programming, as well as the slogan “The Original. The Best.” (Plaintiff’s Rule 56.1 Statement of Material Facts in Opposition, dated March 13, 2000 [“Pl.’s 56 Response”] ¶¶ 6–7, 9.)

Plaintiff adopted the FashionTelevision mark in 1985 (Pl.’s 56 Response ¶ 1) and that mark has been in use in the United States since 1992, when the Program first aired on VH–1. (Pl.’s 56 Statement ¶ 2.) The Program was featured on VH–1 from 1992 through 1999, and is currently shown on E! Entertainment Television (Pl.’s Response ¶¶ 4–5); the Program has received mention in several prominent publications, including TV Guide and Vogue and, according to plaintiff, was VH–1’s highest rated program during one of its seasons. (Plaintiff’s Reply Memorandum of Law, dated March 13, 2000 [“Pl.’s Reply”] p. 12.)

\*2 Plaintiff’s competitors include CNN’s *Style with Elsa Klensch*, MTV’s *House of Style*, E! Entertainment Television’s *Fashion Emergency* and *Fashion File* and E!’s new 24-hour channel “style.” (Plaintiff’s Memorandum of Law in Support of Plaintiff’s Motion to Dismiss, dated February 14, 2000 [“Pl.’s Mem.”] pp. 12–13.) Plaintiff’s Program accounts for less than twenty-five percent of viewers watching these programs. (Pl.’s 56 Statement ¶ 6.)

#### *B. Defendants and their Channel*

Defendants produce a 24-hour television channel [“Defendants’ Channel” or “Channel”] featuring non-stop music and “clips of fashion models on a catwalk.” (Defts.’ Mem. p. 29.) Defendants broadcast their Channel in many countries; in the United States, it is broadcast in Miami and has been available on a trial basis in New York. (Defts.’ Mem. p. 6.)

Defendants’ Channel is named “f l’original,” but defendants at times refer to their products in marketing and other publications as “f l’original Fashion TV,” “FTV,” “FTV The Original,” “Fashion TV The Original,” “Fashion TV” and “Fashion TV Paris.”

(Pl.’s Mem. ¶¶ 12–12; Defts.’ Mem. p. 7.) Defendants refer to their production company as “Fashion TV Paris.” (Id.) Defendant **Lisowski** owns three French trademarks, registered in April, 1998, that are variations on “Fashion Television.” (Defts.’ Mem. p. 2; Declaration of Raymond Dowd, dated June 5, 2000 [“Dowd Decl.”] Exh. A.) It is undisputed that those of defendants’ marks that use the word “fashion” in conjunction with TV or television “look [ ] similar” to the FT Marks. (Deposition of Adam **Lisowski**, dated December 2, 1999 [“**Lisowski** Dep.”] p. 91.)

#### *C. The Parties’ Interactions*

The parties appear to have met at an industry meeting in Cannes in April, 1997. At that meeting, the parties discussed defendants’ new channel and the potential for plaintiff to sell defendants its “Ooh La La” program; plaintiff referred this sale to a junior employee, Tara Orme, for follow-up negotiations. (Defts.’ Mem. pp. 7–8.) Plaintiff understood the parties to have reached agreement, while defendants maintain that they merely expressed interest in the program. (Defts.Mem. p. 8.) During these negotiations, Ms. Orme referred to defendants as “Fashion TV” without objection on her part. (Defts.’ Mem. p. 8–9.)

In May 1997, defendant **Lisowski** allegedly sent an email to Moses Znaimer, a senior employee of plaintiff, which included the following:

The Channel we have created is called F. Sometimes we would like to use the words F.TV—Fashion Television, L’Original.

Though my legal counsel advises me that this is quite alright, as we use F.TV as a trademark, and Fashion Television as a descriptive work, I would like to make sure that we are not infringing on any of your intellectual properties. On the ohter [sic] hand, Fashion Television is more a descriptive matter, rather than an attempt to infringe on your

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rights.

\*3 (Defts.' Mem. p. 12 (uppercase type and other formatting removed).) It is unclear if plaintiff responded to this particular email, but it is undisputed that plaintiff objected to defendants' use of the mark in a June 2, 1997 email to **Lisowski**. (Defts.' Mem. p. 13.)

#### *D. Procedural History*

Plaintiff applied in March 1998 for registration of its Fashion Television mark with the U.S. Patent and Trademark Office ["PTO"] (Defts.' Exh. 15 (Application 75/101,259).) On June 21, 1999, the PTO, after considering plaintiff's application and supporting documentation, entered a final rejection of plaintiff's application. (Defts.' Exh. G.) The PTO examiner found, in part, that "fashion television" was not protectable and that plaintiff would have to disclaim exclusive rights to the use of these words in order for its mark (the specific "Fashion Television" logo) to be registered.

Plaintiff has also applied for a license to broadcast a 24-hour fashion channel in Canada under provisions of Canadian telecommunications law reserving certain channels for broadcasters meeting Canadian ownership requirements and minimum levels of "Canadian content" in their programming. This application currently is pending. (Dowd Decl. Exh. C.)

Plaintiff filed an action in France against defendants on February 27, 1998, asserting various causes of action under French law relating to defendant **Lisowski's** registration of the "Fashion Television" marks in France. The trial court in that action granted plaintiff a preliminary injunction, but this decision was reversed by the Paris Court of Appeals on May 19, 2000. *See S.A.R.L. Fashion TV v. Chum*, 2000/00951 (Paris Court of Appeals, May 19, 2000).

#### *E. The Present Case*

Plaintiff commenced this action on July 16, 1998 and filed an Amended Complaint on October 27, 1998. Defendants filed a motion to dismiss under [Fed.R.Civ.P. 12\(b\)\(1\)](#) and [12\(b\)\(6\)](#), which this Court denied on May 19, 1999. Defendants filed their Answer and Counterclaims on June 29, 1999 and an Amended Answer and Counterclaims on October 4, 1999; this Court, by Order dated October 26, 1999, declined to grant defendants leave to file their Amended Answer and Counterclaims, and deemed their initial Answer and Counterclaims operative in all respects. Plaintiff filed motions to dismiss or for summary judgment on defendants' counterclaims and for sanctions. Defendants filed motions for reconsideration of the Court's October 27, 1999 Order, for summary judgment dismissing plaintiff's claims, and for sanctions. By Order dated February 1, 2000, the Court directed the parties to submit consolidated briefing on these various motions.

## II. PRELIMINARY ISSUES

The Court first considers defendants' motion for reconsideration and the possible preclusive effect of the recent Paris Court of Appeals decision.

#### *A. Defendants' Motion for Reconsideration*

Defendants move for reconsideration of the Court's Order denying defendants leave to amend their Answer and Counterclaims under [Fed.R.Civ.P. 11](#), [15](#), and [16](#). On reconsideration, the Court grants defendants leave, under [Rule 11](#), only to amend their original counterclaims as proposed in their Amended Answer and Counterclaims.

\*4 [Local Civil Rule 6.3](#) allows a party to seek reconsideration based on "matters or controlling decisions which counsel believes the court has overlooked." The court should reconsider its prior order where it "overlooked controlling decisions that may have influenced the earlier result" or failed to consider "factual matters that were put before the court on the underlying motion." [Travelers Ins. Co. v. Buffalo Reinsurance Co.](#), 739 F.Supp. 209, 211

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(S.D.N.Y.1990) (citations omitted); *see also Shrader v. CSX Transp., Inc.*, 70 F.3d 255, 257 (2d Cir.1995). The standard on a motion for reconsideration is strict, however, “ ‘in order to dissuade repetitive arguments on issues that have already been considered fully by the court.’ ” *Travelers*, 739 F.Supp. at 211 (quoting *Caleb & Co. v. E.I. DuPont de Nemours & Co.*, 624 F.Supp. 747, 748 (S.D.N.Y.1985)); *see also Shrader*, 70 F.2d at 257.

The Court finds no reason to reconsider its earlier Order denying leave to amend under [Rules 15](#) and [16](#) because defendants have failed to show good cause. The Second Circuit has recently reaffirmed that “despite the lenient standard of [Rule 15\(a\)](#), a district court does not abuse its discretion in denying leave to amend the pleadings after the deadline set in the scheduling order where the moving party has failed to establish good cause.” *Parker v. Columbia Pictures Industries*, 204 F.3d 326, 340 (2d Cir.2000). The Court found “no good cause for defendants’ delay in amending its answer and counterclaims” because defendants were on notice of the grounds for plaintiff’s motion to dismiss when they consented to the scheduling order precluding further claims and because defendants provided no explanation of why they could not have included the additional claims and parties at the outset. (*see* Order of October 26, 2000 p. 3.)

Defendants now argue that they “demonstrate ‘good cause’ ” because their request “was based on newly discovered evidence and made prior to discovery” and because the Court did not afford defendants “an opportunity to present evidence.” (Defts.’ Mem. pp. 1, 3.) These arguments are without merit. A finding of good cause “depends on the diligence of the moving party.” *Parker*, 204 F.3d at 340. Defendants still have shown no reason why they could not have included their counterclaims and additional parties at the time of their initial answer or during the time between the filing of their initial answer and the deadline for additional claims and parties. In addition, the Court considered two submissions from defendants prior to

issuing its Order (Letters from Jason E. Bogli to Honorable Kimba M. Wood dated October 16 and October 20, 1999); neither of these letters requested an opportunity to present evidence or suggested that the Court should not decide the issues before it on the basis of the parties’ submissions. For these reasons, the Court denies reconsideration of this portion of its ruling.

**\*5** The Court finds, however, that defendants should be allowed to amend their pleadings under [Rule 11](#). [Rule 11\(c\)\(1\)\(A\)](#) provides a party with an opportunity to “withdraw[ ] or appropriately correct[ ]” a “challenged” claim. Because plaintiff challenged defendants’ original counterclaims under [Rule 11](#), defendants should have an opportunity to correct these challenged claims. Although plaintiff contends that defendants ignored earlier requests by plaintiff’s counsel to amend the challenged counterclaims (*see* Pl.’s Mem. p. 20), defendants did eventually respond to plaintiff’s [Rule 11](#) concerns by “amending all counterclaims in the original Answer except for attempted monopolization” and changing the monopolization claim to attempted monopolization.” <sup>FN3</sup> (Defts.’ Mem. p. 3.) The Court now grants defendants leave to effect this limited correction of the challenged counterclaims and deems the initial Answer and Counterclaims superseded by the Amended Answer and Counterclaims to this extent. Defendants’ original Answer and Counterclaims are deemed operative, however, for all other purposes.

**FN3.** Although defendants appeared to be on notice of plaintiff’s [Rule 11](#) challenges prior to September 10, 1999 (*see* Pl.’s Mem. p. 20), the parties’ submissions do not clarify when this earlier communication occurred. The Court therefore accepts defendants’ October 4, 1999 submission as timely under [Rule 11\(a\)\(1\)\(A\)](#).

#### *B. The French Appellate Decision*

Defendants also request that the Court give pre-

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clusive effect to the factual and legal findings of the Paris Court of Appeals, which rendered a decision in a parallel proceeding between the parties earlier this year. The French court determined that plaintiff had no cognizable claim for protection of its “Fashion Television” mark under French or Canadian law. *See S.A.R.L. Fashion TV v. Chum*, 2000/00951 (Paris Court of Appeals, May 19, 2000). For the reasons that follow, the Court finds the French decision not relevant to this case.

First, the Court declines to find res judicata, or claim preclusion, as to the French Court's legal conclusions regarding plaintiff's trademark rights. Whether “a litigant has been awarded or denied rights over a mark in a foreign country ordinarily does not determine its entitlement to the mark in the United States.” *Otokoyama Co. v. Wine of Japan Import, Inc.*, 175 F.3d 266, 273 (2d Cir.1999). Plaintiff's lack of success in procuring foreign trademark protection is not relevant to the inquiry into its protectable rights, if any, in the FT marks under United States law. *See id.*; *see also Jordache Enterprises, Inc. v. Levi Strauss & Co.*, 841 F.Supp. 506 (S.D.N.Y.1993). Accordingly, the Court does not treat the Paris Court of Appeals' legal conclusions as res judicata.

Second, the Court also declines to give collateral estoppel, or issue preclusion, effect to the French Court's factual findings. Defendants claim that the French Court found that: (1) defendant **Lisowski** had no knowledge of plaintiff's activities; (2) plaintiff has no rights in the FT Marks under French or Canadian law; (3) the market for television programs is distinct from the market for television channels and there is no likelihood of confusion between the two markets; and (4) plaintiff suffered no injury because its investments in a 24-hour channel came after the success of defendants' channel. The Court concludes that it should not be bound by any of these “findings.”

\*6 It is well-settled that “[f]or collateral estoppel to apply, the issues in each action must be identical,

and issues are not identical when the legal standards governing their resolution are significantly different.” *Computer Assocs. Inter., Inc. v. Altai, Inc.*, 126 F.3d 365 (2d Cir.1997). This case focuses on the parties' United States activities, as to which the French court made no findings. Moreover, the findings of the Paris Court of Appeals were predicated on French legal standards. Defendants maintain that the French court found that defendant **Lisowski** had “no knowledge of **Chum's** activities.” A closer reading of the French decision, however, reveals that plaintiff did not prove that defendant **Lisowski** had sufficient familiarity with plaintiff's Program to meet the elements of fraud under French law. Similarly, the French court made a finding on the likelihood of confusion under article L of the French Rules of Intellectual Property and a finding on plaintiff's injury under several French causes of action. Defendants have provided no evidence that the legal standards governing fraud, trademark confusion, or injury in France are identical to any of the legal standards governing the myriad claims in this case. *See id.* (requiring moving party to show that legal standards are “identical”). Finally, the last factual issue—the protectability of the FT Marks in Canada and France—is not relevant to the issue of the protectability of the FT Marks under United States law, as discussed above. For these reasons, the Court denies defendants' request that the factual and legal conclusions of the Paris Court of Appeals be considered binding in this case.

### III. SUMMARY JUDGMENT STANDARD

To prevail on a motion for summary judgment, the moving party must show that there are no genuine issues of material fact to be tried, and that it is entitled to judgment as a matter of law. *See Fed.R.Civ.P. 56(c); Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986); *Carlton v. Mystic Transp., Inc.*, 202 F.3d 129, 133 (2d Cir.2000). The party seeking summary judgment must identify materials in the record that “it believes demonstrate the absence of a genuine issue of material fact.” *Celotex Corp.*, 477 U.S. at 323. The non-moving party must then set forth specific facts

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that show that there is a genuine issue to be tried. See *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251–52 (1986).

In considering the motion, the Court views the evidence in the light most favorable to the non-moving party and draws all reasonable inferences in its favor, see *Carlton*, 202 F.3d at 133. The non-moving party, however, “must do more than simply show that there is some metaphysical doubt as to the material facts.” *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986). Summary judgment is appropriate in trademark infringement cases where plaintiffs fail to produce evidence to support their claims. See, e.g., *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 876 (2d Cir.1986). If, on the record presented, no rational fact-finder could find in the non-movant's favor, summary judgment is appropriate. See *Anderson*, 477 U.S. at 250; *Carlton*, 202 F.3d at 134.

#### IV. DEFENDANTS' MOTION FOR SUMMARY JUDGMENT

\*7 Defendants seek summary judgment dismissing plaintiff's trademark infringement, dilution, and unfair competition claims.<sup>FN4</sup> For the reasons set forth below, the Court grants summary judgment on the trademark infringement and dilution claims, but denies summary judgment on the unfair competition claim.

**FN4.** Defendants also press an affirmative defense of laches, arguing that plaintiff failed to take timely action after learning of their infringing activities. If the delay in protesting a Lanham Act violation exceeds the analogous state statute of limitations period (here, the New York fraud period of six years), then a presumption of laches will arise; otherwise, the burden is on defendant to prove the defense. See *Conopco, Inc. v. Campbell Soup Co.*, 95 F.3d 187, 191–93 (2d Cir.1996). The length of the delay in this case is in dispute,

but it is a matter of weeks or months, not years. Defendants thus have the burden of showing laches, and the Court finds that they cannot do so.

To show laches, defendants must show that they have been prejudiced by a plaintiff's unreasonable delay in objecting to their infringing use. See *Conopco*, 95 F.3d at 192. Defendants argue that they committed to using the infringing marks in April of 1997 and that plaintiff did not object until June 2, 1997; defendants point out that a junior employee of plaintiff referred to defendants in correspondence as “Fashion TV” without objection, and that **Lisowski** wrote to plaintiff in May 1997 to inform plaintiff that defendants intended to use the infringing marks. Defendants maintain that the several week delay prior to objection, followed by the one year delay in filing the complaint, were unreasonable, and that in the interim, defendants reasonably committed resources to their “Fashion TV” mark.

The Court finds this argument to be without merit. The one month (at most) delay in response by plaintiff was not unreasonable under the circumstances, given that plaintiff would have needed time to receive the correspondence, discuss it with employees and legal counsel, and formulate a response. Defendants provide no evidence either that this four week delay was unreasonable, or that the delay of about one year between demanding cessation of defendants' use of the “Fashion TV” mark and filing this action was unreasonable. Defendants also offer no evidence of how, if at all, defendants were prejudiced. The Court therefore dismisses the laches defense as a matter of law.



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#### A. Trademark Infringement

Plaintiff alleges that defendants have infringed on its trademarks in violation of the Lanham Act, 15 U.S.C. § 1125(a). (citing *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938)). Because plaintiff's marks are not registered in the United States, plaintiff bears the burden of demonstrating that it has a "valid trademark entitled to protection" in order to succeed on its trademark infringement claim. *Genesee Brewing Co., Inc. v. Stroh Brewing Co.*, 124 F.3d 137, 142 (2d Cir.1997); see also *Reese Publishing Co. v. Hampton Int'l Comm., Inc.*, 620 F.2d 7, 11 (2d Cir.1980); *Brandwynne v. Combe International, Ltd.*, 74 F.Supp.2d 364, 380 (S.D.N.Y.1999). The Court concludes below that plaintiff cannot meet this burden and that "fashion television" is not protected under trademark law.<sup>FN5</sup>

FN5. To prevail on its common law infringement claim, plaintiff must meet the same standard of demonstrating that it possesses a valid, protectable mark. See *Tri-Star Pictures, Inc. v. Leisure Time Prods. B.V.*, 17 F.3d 38, 43 (2d Cir.), cert. denied, 513 U.S. 987 (1994); *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 581–82 (2d Cir.1990). The Court therefore considers these two claims together.

A mark is protectable if it is sufficiently distinctive. Courts rank marks, in ascending order of distinctiveness, as generic, descriptive, suggestive, fanciful, or arbitrary. See *Thompson Medical Co., Inc. v. Pfizer Inc.*, 753 F.2d 208, 212 (2d Cir.1985). Generic marks, which "describe the article or substance represented," *Bernard v. Commerce Drug Co., Inc.*, 774 F. Supp 103, 106 (E.D.N.Y.1991), are not distinctive and thus not protectable; they refer merely to the "genus of which the particular product is a species." See *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985).

Courts in the Second Circuit have consistently held that terms that merely describe the content of a particular media offering are generic. See, e.g., *Reese Publishing Co. v. Hampton International Communications, Inc.*, 620 F.2d 7, 11 (2d Cir.1980) ("Video Buyers Guide" generic as book title); *CES Publishing Corp v. St. Regis Publications*, 531 F.2d 11 (2d Cir.1975) ("Consumer Electronics Monthly" generic as magazine title); *GMT Productions v. Cablevision of New York*, 816 F.Supp. 207 (S.D.N.Y.1993) ("The Arabic Channel" generic as television channel name); see also *Genesee Brewing Co., Inc.*, 124 F.3d at 137 (finding that "Honey Brown," as applied to beer, was generic). The policy behind such decisions is that allowing registration of such a generic mark would contribute to a monopoly by precluding competitors from using a common word that merely describes the item or services in question. See *CES Publishing*, 531 F.2d at 13; *Sportschannel Associates v. Commissioner*, 903 F.Supp. 418, 423 (E.D.N.Y.1995).

In determining whether a particular mark is generic, courts in the Second Circuit look to several factors, including evidence of: (1) generic use of the term by competitors which plaintiff has not challenged or generic use by plaintiff himself; (2) dictionary definitions, which may be relevant while not dispositive; (3) generic usage in trade journals or newspapers; (4) testimony of persons in the trade; and (5) consumer surveys. See *Brandwynne*, 74 F.Supp.2d at 381 (citing 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:13 (4th ed.1999) [hereinafter "*McCarthy*"]. As described above, the burden is on plaintiff to show that its unregistered mark is not generic.

\*8 Although plaintiff has presented evidence that it polices its mark against conflicting use, including court actions against allegedly infringing users (Defts. Exh. 2; Deposition of Moses Znaimer ["Znaimer Dep."], dated January 20, 2000, pp. 111–113), it has not met its burden on any of the other *Brandwynne*

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factors. Plaintiff presented neither objective testimony from industry professionals as to the plaintiff's mark not being generic, *see Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902 (9th Cir.1995) (according little weight to testimony of interested parties), nor any dictionary definition of “fashion television.” Defendants, by contrast, have provided a definition of “fashion” from the *New Shorter Oxford English Dictionary* (Clarendon Press 1993) presenting this term as a commonly used descriptive word for style; that dictionary gives examples (“fashion-paper” [“journal dealing with fashionable life”] and “fashion house” [“business establishment displaying and selling high-quality clothes”] ) that suggest, by analogy, that fashion television refers to television that deals with (or sells) fashion. (Defts.' Exh. K.) Defendants have also provided evidence of generic use from an industry professional in the form of a published article by designer Isaac Mizrahi discussing the genre of fashion television. (Defts.' Exh. 7.)

Plaintiff's evidence of nongeneric use of “fashion television” to describe its show (Pl.'s Exh. 7) is outweighed by defendants' evidence of generic usage of “fashion television” in the press. (Defts.' Exh. 7; Defts.' Exh. 15, pp. 70, 71, 78 [examples in plaintiff's submission to PTO showing generic use of fashion television in press] ).<sup>FN6</sup> The Court also gives weight to the PTO examiner's determination that “fashion television” is generic.<sup>FN7</sup> (Deft.'s Exh. F.) For these reasons, the Court finds that plaintiff has produced insufficient evidence to meet its burden of demonstrating that it has a valid trademark entitled to protection and that defendants are entitled to judgment as a matter of law on plaintiff's trademark infringement claims.

**FN6.** A brief Westlaw search by the Court of recent U.S. publications revealed several examples of generic use of “fashion television.” *See, e.g.,* Michelle Crowe, “Instant Style,” *Chi. Tribune*, Sept. 20, 2000 at p. 5,

available at [2000 WL 3710512](#).

**FN7.** The parties disagree as to the proper level of deference to accord the PTO determination. Although there appears no authority directly on point, the Court concludes that the determination should be given weight but is not dispositive. *Cf. Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384 (2d Cir.1995) (PTO registration creates rebuttable presumption of secondary meaning); *Sterling Drug, Inc. v. Bayer AG*, 14 F.3d 733, 743 (2d Cir.1994) (court must make independent review of the likelihood of consumer confusion); *Goya Foods, Inc. v. Tropicana Prods., Inc.*, 846 F.2d 848, 853 (2d Cir.1988) (challenge to PTO determination is “virtually de novo”).

#### *B. Trademark Dilution*

Plaintiff also seeks injunctive relief against defendants' use of the infringing marks under federal and state trademark dilution laws. Section 43(c) of the Lanham Act, [15 U.S.C. § 1125\(c\)](#), protects from dilution the distinctive quality of famous marks. [Section 368-d of New York's General Business Law](#) provides injunctive relief if there is a likelihood of dilution of the distinctive quality of a mark or trade name or in cases of unfair competition, “notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services.”

To prevail on a Lanham Act dilution claim, plaintiff must show ownership of a famous mark and dilution of that mark. *See Clinique Labs., Inc. v. Dep Corp.*, 945 F.Supp. 547, 561 (S.D.N.Y.1996). Similarly, plaintiff must show ownership of a distinctive mark and likelihood of dilution under [New York General Business Law § 368-d](#). *See Hormel Foods Corp. v. Jim Henson Productions, Inc.*, 73 F.3d 497, 506 (2d Cir.1996); *McDonald's Corp. v. McBagel's, Inc.*, 649 F.Supp. 1268, 1280 (S.D.N.Y.1986). In both

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cases, a finding that the mark in question is generic precludes recovery. See *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 810 (2d Cir.1999); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir.1976); *Telford Home Assistance, Inc. v. TPC Home Care Services, Inc.*, 211 A.D.2d 674, 674 (2d Dept.1995); see also 4 *McCarthy* § 24.91, p. 24-154 (noting that “basic trademark principles” dictate that a mark must be distinctive to be eligible for protection under federal dilution law). Because the Court has concluded that “fashion television” is generic, plaintiff’s dilution claims must be dismissed.

### C. Unfair Competition

\*9 The fifth count of plaintiff’s Complaint includes a claim for common law unfair competition. The essence of unfair competition is “ ‘the bad faith misappropriation of the labors and expenditures of another, likely to cause confusion or to deceive purchasers as to the origin of the goods.’ ” *Rosenfeld v. W.B. Saunders*, 728 F.Supp. 236, 249-50 (S.D.N.Y.1990) (quoting *Computer Assocs. Int’l, Inc. v. Computer Automation, Inc.*, 678 F.Supp. 424, 429 (S.D.N.Y.1987), *aff’d*, 923 F.2d 845 (2d Cir.1990)). Unfair competition “encompasses a broad range of unfair practices.” *Forschner Group, Inc. v. Arrow Trading Co., Inc.*, 904 F.Supp. 1409, 1427 (S.D.N.Y.1995). An unfair competition claim is not foreclosed by a finding that plaintiff’s mark is generic. See *Forschner Group, Inc.*, 30 F.3d at 358-59 (relief available even if mark generic “ab initio”); see also *Genesee Brewing Co.*, 124 F.3d at 149; *Murphy Door Bed Co. v. Interior Sleep Systems*, 874 F.2d 95, 102 (2d Cir.1989).

Where, as here, a plaintiff brings an unfair competition claim seeking equitable relief, the plaintiff must show a likelihood of confusion, see *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 35 (2d Cir.1995); *W.W.W. Pharmaceutical Co. v. Gillette Co.*, 984 F.2d 567, 576 (2d Cir.1993), and must also make “some showing of bad faith,” see *id.*; *Saratoga Vichy Spring Co. v. Lehman*, 625 F.2d 1037,

1044 (2d Cir.1980). The Court finds material facts in dispute on these elements sufficient to defeat summary judgment.

### I. Likelihood of Confusion

In *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.1961), the Second Circuit set out eight non-exclusive factors that courts should weigh to determine the likelihood of confusion: (1) the strength of the mark; (2) the degree of similarity between the two marks; (3) the proximity of the products; (4) the likelihood that the prior owner will “bridge the gap”; (5) actual confusion; (6) defendants’ good faith in adopting its mark; (7) quality of the defendants’ product; and (8) the sophistication of the buyers. See *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.1961). Although the *Polaroid* test is typically used in trademark infringement claims, most courts in the Second Circuit apply the *Polaroid* test to determine confusion under common law unfair competition. See, e.g., *Eastern America Trio Prods. v. Tang Electronic*, 97 F.Supp.2d 395, 420-22 (S.D.N.Y.2000); *La Cibeles, Inc. v. Adipar, Ltd.*, No. 99 Civ. 4129, 2000 WL 1253240 (S.D.N.Y. Sept. 1, 2000); *Cartier, Inc. v. Deziner Wholesale, L.L.C.*, No. 98 Civ. 4947, 2000 WL 347171, at \*6 (S.D.N.Y. Apr. 3, 2000). But see *Forschner Group, Inc.*, 904 F.Supp. at 1420-21 n. 15 (finding *Polaroid* inapplicable when mark is generic but using a similar analysis to determine likelihood of confusion). The Court takes up its analysis of these factors in turn.

\*10 (1) *Strength of the Mark*. Because plaintiff’s marks are generic, the strength of these marks must be demonstrated through secondary meaning. See *Genesee*, 124 F.3d at 150 and n. 4. To demonstrate secondary meaning, plaintiff must show that a “typical consumer is more likely to associate the trademark with the product, rather than with the thing it purportedly describes.” See *Bernard*, 774 F.Supp. at 106; see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 404 U.S. 763, 769 (1992). In *Genesee Brewing Co.*, the Second Circuit listed several factors to consider in



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determining secondary meaning: advertising expenditures; consumer studies linking the mark to a source; unsolicited media coverage of the product; sales success; attempts to plagiarize the mark; and length and exclusivity of the mark's use. *See* 124 F.3d at 143 n. 4.

Plaintiff has presented evidence that it has used the FT Marks since about 1985, that the Program has reached a national audience via VH-1 and E! for almost 10 years, and that the Program has attracted substantial unsolicited media coverage and has had extensive success on VH-1. Plaintiff also points to defendants' actions as proof that the marks are worth plagiarizing. Although plaintiff has presented neither consumer studies nor evidence of its advertising expenditures, the Court finds that the evidence cited above, taken in the light most favorable to plaintiff, could lead a reasonable jury to conclude that the FT Marks have acquired secondary meaning and are strong. *See Lang v. Retirement Living Pub. Co, Inc.*, 949 F.2d 576, 578–80 (2d Cir.1991); *see also Walt Disney Co. v. Cable News Network*, 231 U.S.P.Q. 235 (C.D.Cal.1986) (three months of broadcast on CNN sufficient to give secondary meaning to the television program title “Business Day.”). This factor therefore weighs in plaintiff's favor.

(2) *Similarity of the Marks*. In determining whether the two marks are similar, the Court looks to the effect on prospective purchasers. *See McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1133 (2d Cir.1979) (crucial question is whether similarity is likely to “provoke confusion”). Defendants concede that the infringing marks “look[ ] similar.” (**Lisowski** Dep. p. 91.) This factor thus favors plaintiff.

(3) *Similarity of the Products*. Similarity is “premised on whether the total effect of the logos and the context in which they are found [is] likely to cause confusion among prospective consumers .” *See Something Old, Something New, Inc. v. QVC, Inc.*, No. 98 Civ. 7450, 1999 WL 1125063 (S.D.N.Y. Dec. 8, 1999). It is undisputed that the allegedly infringing

marks do not appear on defendants' Channel itself. Consequently, the Court examines the “total effect” of the marks in the context of the fashion and media industries, where the parties compete for advertisers, trade contacts, and content. In this context, the editorial distinctions between the parties' products are not evident to the relevant consumers, and a trier of fact could reasonably conclude the products appear similar to the industry professionals. This factor favors plaintiff.

\*11 (4) *Bridging the Gap*. Because plaintiff's mark is generic, it is not entitled to bridge the gap. *Cf. Forschner Group*, 904 F.Supp. at 1420–23. This factor is neutral.

(5) *Actual Confusion*. This factor considers whether any consumers “have actually been confused by the products bearing the allegedly confusing marks.” *See Centaur Communications v. A/S/M Communications*, 830 F.2d 1217, 1227 (2d Cir.1987). Evidence of actual confusion may consist of consumer survey evidence or “anecdotal evidence of confused consumers in the marketplace.” *Jordache Enterprises, Inc.*, 841 F.Supp. at 518; *see also id.* Plaintiff alleges several incidents in which fashion professionals failed to correctly distinguish the parties. Plaintiff's evidence in support of these allegations, however, consists solely of statements from various of plaintiff's employees that are both self-serving and predominantly inadmissible hearsay. Although **Lisowski** admitted in his deposition that he is “sure that there has been confusion” (**Lisowski** Dep. at 114), he testified that he did not know of any such confusion (*id.*). Because plaintiff has produced no competent evidence of actual confusion, the Court finds that this factor favors defendants.

(6) *Good Faith*. Although subsequent producers have the right to use generic marks, they have “an obligation ‘to use every reasonable means to prevent confusion’ as to the source of the products.” *Genesee*, 124 F.3d at 150 (citing *Kellogg*, 305 U.S. at 121). The

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parties have raised a question of material fact as to whether defendants chose to mimic the FT Marks in order to get a “foot in the door” of the fashion programming market (as plaintiff contends) or whether defendants relied in good faith on the opinion of legal counsel that their use of the FT Marks did not infringe on plaintiff's marks (as defendants contend). Plaintiff points to defendants' May 1997 e-mail as evidence of defendants' intentional copying. See *Jordache Enterprises, Inc.*, 841 F.Supp. at 519 (intentional copying of mark may be evidence of intent to create confusion among products). Defendants cite this same e-mail to show their good faith reliance on legal counsel in using the marks. See *Arrow Fastener*, 59 F.3d at 397 (knowledge of prior use can be consistent with good faith); *W.W.W. Pharmaceutical Co. v. Gillette Co.*, 984 F.2d 567, 575 (2d Cir.1993) (good faith can be established by reliance on legal opinion). This disputed question of intent is “best left in the hands of the trier of fact.” *The Sports Authority, Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 964 (1995). In deciding this motion, an inference can be drawn in favor of plaintiff.

(7) *Quality*. This factor “is primarily concerned with whether the senior user's reputation could be jeopardized” by the inferior quality of defendant's product. *Trustees of Columbia Univ. v. Columbia/HCA Healthcare Corp.*, 964 F.Supp. 733, 747 (S.D.N.Y.1997). The parties agree that plaintiff produces a polished, magazine-format program, while defendants essentially broadcast runway footage set to music. The alleged inferiority of defendant's programming could jeopardize plaintiff's reputation for high quality programming, see *Hormel Foods Corp. v. Jim Henson Prods*, No. 95 Civ. 5473, 1995 WL 567369 (S.D.N.Y. Sept. 25, 1995). On the other hand, the difference between the quality of the programs reduces the likelihood of confusion. See *Girl Scouts v. Bantam Doubleday Dell Publishing Group, Inc.*, 808 F.Supp. 1112, 1129 (S.D.N.Y.1992). Because neither party provided adequate briefing or evidence on this factor, the Court finds that it is neutral for purposes of

the motion.

\*12 (8) *Sophistication of Buyers*. This factor is premised on “the belief that unsophisticated consumers aggravate the likelihood of confusion,” *Hasbro, Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70, 78 (2d Cir.1988), and that consumer sophistication typically “mitigates against a finding of a likelihood of confusion,” *Centaur Communications Ltd.*, 830 F.2d at 1228. Defendants in this case have used the infringing marks exclusively to market and promote their Channel within the fashion and media industries. For this reason, only the sophistication of the professionals in these industries is relevant in analyzing this *Polaroid* factor. Because plaintiff concedes that these professionals are sophisticated (Pl.'s Reply p. 8), the Court finds that this factor favors defendant.

#### (9) *Summary of Polaroid Factors*

In sum, four of the factors favor plaintiff, two favor defendant, and two are neutral. Balancing these factors, the Court concludes that a trier of fact could reasonably find a likelihood of confusion. Summary judgment is inappropriate because material facts remain in dispute on at least three factors. See *Cadbury Beverages, Inc. v. Cott Corp.*, 73 F.3d 474, 483–84 (2d Cir.1996).

#### 2. *Bad Faith*

As discussed in the preceding analysis, an inference of defendants' bad faith may be drawn from plaintiff's evidence for purposes of deciding this motion, and resolution of the question of bad faith is best left for the trier of fact.

For the reasons stated above, the Court concludes that plaintiff has made a prima facie showing of common law unfair competition. Because the evidence reveals substantial disputes over material facts, the Court denies summary judgment on this claim.

#### V. PLAINTIFF'S MOTION FOR SUMMARY

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#### JUDGMENT

Defendants' sole counterclaim <sup>FN8</sup> alleges that plaintiff engaged in attempted monopolization of the fashion television broadcasting market in violation of the Sherman Act, 15 U.S.C. § 2. <sup>FN9</sup> (Defendants' First Amended Answer to First Amended Complaint [Defts.' Amended Answer"] ¶¶ 125–40.) Plaintiff moves to dismiss this claim under Rule 12(b)(6) or for summary judgment. Because both parties engaged in discovery and submitted outside materials for the Court's consideration, the Court decides plaintiff's motion under the Rule 56 summary judgment standard. See Rule 12(b). The Court finds that defendants' counterclaim fails as a matter of law.

**FN8.** As discussed above, the remainder of the counterclaims in defendants' original pleadings were withdrawn and the Court denied defendants leave to add other counterclaims after the deadline set in the Scheduling Order for lack of good cause.

**FN9.** Because the Court denied defendants leave to add new counterclaims, the Court declines to permit a claim for unfair competition as an alternative to defendants' attempted monopolization claim. (Defts.' Mem. p. 32). Defendants also seek, as an amendment to their Lanham Act counterclaim, a declaratory judgment “that the application for [the FT Marks] were fraudulently made, are generic, and all intellectual property interest of Plaintiff in the terms Fashion, Television, and FT. [sic]” (Defts.' Amended Answer ¶¶ 108–111.) Because defendants fail to articulate a legal basis for this claim, the Court declines to consider it.

To make out a prima facie case of attempted monopolization and survive summary judgment, defendants must offer evidence that plaintiff (a) engaged in anticompetitive or predatory conduct (b) with a specific intent to monopolize and (c) with a dangerous

probability of achieving monopoly power. See *Spectrum Sports, Inc. v. McQuillan*, 506 U.S. 447, 456 (1993); *Twin Laboratories, Inc. v. Weider Health & Fitness*, 900 F.2d 566, 570 (2d Cir.1990). As the Second Circuit explained in *Twin Laboratories*, “sufficient market share by the defendant” is a threshold showing because such market share is “the primary indicator of the existence of a dangerous probability of success.” *Twin Laboratories*, 900 F.2d at 570. Market share is ascertained with reference to the relevant product and geographic markets. See *Walker Process Equipment, Inc. v. Food Machinery & Chemical Corp.*, 382 U.S. 172, 177 (1965).

**\*13** The Court understands defendants' antitrust claim to refer to the United States market for fashion programming. Defendants have not shown that plaintiff's market share, in the specific context of the market for fashion programming, suggests a dangerous probability of monopoly in this market or that plaintiff is likely to gain a monopoly in the foreseeable future. <sup>FN10</sup> The undisputed evidence is that plaintiff possesses less than a twenty-five percent share of the United States market for fashion programming (Declaration of Marcia Martin, dated September 9, 1999, ¶ 10), and that plaintiff competes with several other producers of fashion programming—including CNN, MTV, E!, and defendants—within this market. Defendants have offered no evidence that there exist barriers to entry or other factors that would suggest that plaintiff's market power is not adequately reflected by its current market share. <sup>FN11</sup> The Court finds that the evidence proffered by defendants of plaintiff's market share does not support a Sherman Act claim. Accordingly, defendants' antitrust counterclaim is dismissed as a matter of law.

**FN10.** Defendants have argued that the Second Circuit's recent decision in *Primetime 24 Venture v. National Broadcasting Company, Inc.*, 219 F.3d 92 (2d Cir.2000) is “controlling” in this case. The *Primetime* court considered the antitrust standards gov-

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erning concerted actions by a group of television networks against a satellite broadcaster. Relying on the *Noerr-Pennington* doctrine, the court found that plaintiff had stated a claim under the Sherman Act sufficient to survive a [Rule 12\(b\)\(6\)](#) motion to dismiss. The court also held that a series of legal proceedings by a company against one or more of its competitors did not violate the Sherman Act unless the acts were “part of a pattern or practice of successive filings undertaken essentially for purposes of harassment” and “brought pursuant to a policy of starting legal proceedings without regard to the merits and for the purpose of injuring a market rival.” *Id.* at 101. Because defendants fail to present any evidence in support of their claim that plaintiff started this proceeding, or the French action, without regard to the merits and solely for purposes of harassment, defendants cannot rely on *Prime-time* to defeat summary judgment on their antitrust counterclaim.

**FN11.** The Court also rejects defendants' contention that plaintiff's application for a license to produce a 24-hour fashion channel in Canada is likely to result in plaintiff's domination of the United States market. In determining whether to apply the Sherman Act to a foreign act, “the inquiry should be directed primarily toward whether the challenged restraint has, or is intended to have, any anticompetitive effect upon United States commerce, either commerce within the United States or export commerce from the United States.” See *Canada v. Interbank Card Assoc.*, 666 F.2d 6, 8 (2d Cir.1981); see also *McElderry v. Cathay Pacific Airways, Ltd.*, 678 F.Supp. 1071, 1077 (S.D.N.Y.1988)(conduct must have a “direct, substantial, and reasonably foreseeable effect” on United States commerce). The Court

finds that defendants have failed to produce competent evidence that plaintiff's application for a Canadian broadcasting license, even if successful, will have an anticompetitive effect upon United States commerce, or that plaintiff intended such an effect.

## VI. SANCTIONS

### A. Defendants' Motion for Sanctions

Defendants allege that plaintiff failed to divulge the status of its trademark application, falsely relied on a “pending” application after the application had been denied, failed to produce the PTO file wrapper under automatic disclosure rules of [Fed.R.Civ.P. 26\(a\)\(1\)](#), and failed to produce the Canadian trademark file wrapper. Defendants claim further that plaintiff's counsel failed in their ethical obligations, pursuant to N.Y. Professional Disciplinary Rules § 1200.37 and § 1200.33, to reveal the application denial to the Court and defense counsel. The Court finds that sanctions are not warranted for the reasons that follow.

First, defendants' allegations concerning the nonproduction of the PTO wrapper are without merit because during the relevant time period, Local Rule 26.4 rendered inoperative the automatic disclosure provisions of [Fed.R.Civ.P. 26](#).

Second, defendants' allegations concerning the Canadian wrapper are insufficient to warrant sanctions. [Rule 11\(d\)](#) specifically excludes discovery from the ambit of its sanctions; [Fed.R.Civ.P. 37\(d\)](#) provides sanctions for misconduct during discovery, but requires that a party moving for sanctions certify “that the movant has in good faith conferred or attempted to confer with the party not making the disclosure in an effort to secure the disclosure without court action.” [Fed.R.Civ.P. 37\(a\)\(2\)\(A\)](#). The Court has no evidence of such certification. Moreover, defendant has not provided the Court with reason to question plaintiff's claims that it produced the Canadian wrapper when requested to do so in proper form; that defendants' earlier document requests were “vague and overly

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broad”; and that defendants failed to respond to plaintiff’s objections and requests for clarification.

Third, defendants provide no evidence that plaintiff’s counsel intended to mislead the Court or opposing counsel on the issue of its pending trademark application.

**\*14** For these reasons, the Court finds that sanctions are not warranted against plaintiff or its counsel.

#### *B. Plaintiff’s Motion for Sanctions*

Plaintiff moves for sanctions against defense counsel. The Court concludes that sanctions are not warranted.

Plaintiff first claims that defense counsel undertook “little to no factual or legal investigation” prior to filing the initial counterclaims, initially refused to modify these claims, and “merely attempted to recast” the claims subsequent to plaintiff’s filing of its initial motion to dismiss. (Pl.’s Mem. p. 20.) In determining whether an attorney should be sanctioned for bringing a frivolous claim, the relevant inquiry is whether a competent attorney could have formed the reasonable belief that the pleadings were “warranted by existing law or a good faith argument for the extension, modification or reversal of existing law.” *Eastway Construction Corp. v. City of New York*, 762 F.2d 243, 254 (2d Cir.1985). It is important to note that it must be ‘patently clear that a claim has absolutely no chance of success.’ *Sussman v. Bank of Israel*, 56 F.3d 450 (2d Cir.1995) (quoting *Oliveri v. Thompson*, 803 F.2d 1265, 1275 (2d Cir.1986); see also *McElderry v. Cathay Pacific Airways*, 678 F.Supp. 1071, 1079 (S.D.N.Y.1988) (no sanctions warranted in antitrust claim). Although defendants’ antitrust claim was without merit, it is not so ‘patently clear’ that it could not succeed that sanctions are warranted.

Plaintiff also claims that defendants’ submissions are “riddled with misrepresentations,” including (1)

describing plaintiff’s French action as based on a “fake” copyright when the French decision made no such determination; (2) describing plaintiff as applying to the government of Canada for a “monopoly” when plaintiff was submitting an application pursuant to Canadian law; and (3) suggesting to the Court that a press release on plaintiff’s website was lying about the status of the French action, rather than merely appearing in the archive of old documents. A Court may impose sanctions on counsel under [Rule 11\(b\)\(3\)](#) for allegations and other factual contentions that lack evidentiary support. See *O’Brien v. Alexander*, 101 F.3d 1479, Although the Court agrees that defendants’ statements were misleading, the Court does not find that the statements rise to the level of direct falsehood that typically warrants sanction under [Rule 11\(b\)\(3\)](#). See, e. g., *Polar International Brokerage Corp. v. Reeve*, 2000 WL 1127936, \*4 (S.D.N.Y. Aug. 8, 2000) (sanctions imposed when counsel alleged two factually contradictory positions). The Court does not condone these statements, but merely holds that they do not merit the application of sanctions in this instance.

#### VII. CONCLUSION

For the reasons set forth above, the Court denies in part and grants in part defendants’ request for reconsideration of this Court’s Order denying leave to amend its answer and counterclaims, grants summary judgment on defendants’ counterclaims, grants summary judgment on plaintiff’s trademark infringement and trademark dilution claims, denies summary judgment on plaintiff’s unfair competition claim, and denies the parties’ motions for sanctions.

**\*15** The parties are directed to submit a joint pretrial order and accompanying memoranda, in accordance with the Court’s Individual Rules, by April 10, 2001.

SO ORDERED.

Not Reported in F.Supp.2d, 2001 WL 243541 (S.D.N.Y.), 2001-1 Trade Cases P 73,275  
(Cite as: **2001 WL 243541 (S.D.N.Y.)**)

S.D.N.Y.,2001.

Chum Ltd. v. Lisowski

Not Reported in F.Supp.2d, 2001 WL 243541  
(S.D.N.Y.), 2001-1 Trade Cases P 73,275

END OF DOCUMENT



**Full docket text for document 89:**

JUDGMENT, that for the reasons stated in the Court's Opinion (86852) dated 4/18/02, judgment is entered in favor of defts on plntf's unfair competition claims (signed by James M. Parkison, Clerk of Court); Mailed copies and notice of right to appeal. Entered On Docket: 4/24/02. (cd)

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Transaction Receipt			
04/08/2015 15:43:35			
<b>PACER Login:</b>	db7930:4109439:0	<b>Client Code:</b>	ftv
<b>Description:</b>	History/Documents	<b>Search Criteria:</b>	1:98-cv-05060-CBM-AJP
<b>Billable Pages:</b>	1	<b>Cost:</b>	0.10

ECF

**U.S. District Court  
Southern District of New York (Foley Square)  
CIVIL DOCKET FOR CASE #: 1:14-cv-09856-KBF**

F. Tv Ltd. et al v. Bell Media Inc.  
Assigned to: Judge Katherine B. Forrest  
Cause: 28:1331 Fed. Question

Date Filed: 12/12/2014  
Jury Demand: Plaintiff  
Nature of Suit: 840 Trademark  
Jurisdiction: Federal Question

**Plaintiff**

**F. Tv Ltd.**  
*a British Virgin Islands Corporation*

represented by **Raymond James Dowd**  
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*LEAD ATTORNEY*  
*ATTORNEY TO BE NOTICED*

**Samuel Asher Blaustein**  
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*LEAD ATTORNEY*  
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**Plaintiff**

**Fashion TV Programmgesellschaft  
MbH**

represented by **Raymond James Dowd**  
(See above for address)  
*LEAD ATTORNEY*  
*ATTORNEY TO BE NOTICED*

**Samuel Asher Blaustein**  
(See above for address)  
*LEAD ATTORNEY*  
*ATTORNEY TO BE NOTICED*

V.

**Movant**



**Fross Zelnick Lehrman & Zissu, P.C.**

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*LEAD ATTORNEY*  
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V.

**Defendant**

**Bell Media Inc.**

*a Canadian corporation, as successor-  
in-interest to Chum Limited, a  
Canadian Corporation  
TERMINATED: 05/14/2015*

represented by **Elizabeth A. McNamara**  
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**Defendant**

**Bigfoot Media, Inc.**

**Defendant**

**Bigfoot Entertainment, Inc.**

represented by **Jennifer Philbrick McArdle**  
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**ATTORNEY TO BE NOTICED**

Date Filed	#	Docket Text
12/12/2014	<a href="#"><u>1</u></a>	COMPLAINT against Bell Media Inc.. (Filing Fee \$ 350.00, Receipt Number 465401112196)Document filed by Fashion TV Programmgesellschaft MbH, F. Tv Ltd.. (Attachments: # <a href="#"><u>1</u></a> Exhibit A, # <a href="#"><u>2</u></a> Exhibit B, # <a href="#"><u>3</u></a> Exhibit C, # <a href="#"><u>4</u></a> Exhibit D, # <a href="#"><u>5</u></a> Exhibit E, # <a href="#"><u>6</u></a> Exhibit F, # <a href="#"><u>7</u></a> Exhibit G, # <a href="#"><u>8</u></a> Exhibit H, # <a href="#"><u>9</u></a> Exhibit I)(moh) (Entered: 12/16/2014)
12/12/2014		SUMMONS ISSUED as to Bell Media Inc.. (moh) (Entered: 12/16/2014)
12/12/2014		Magistrate Judge James L. Cott is so designated. (moh) (Entered: 12/16/2014)
12/12/2014		Case Designated ECF. (moh) (Entered: 12/16/2014)
12/12/2014	2	CIVIL COVER SHEET filed. (moh) (Entered: 12/16/2014)
12/12/2014		Mailed notice to Commissioner of Patents and Trademarks to report the filing of this action. (rdz) (Entered: 03/23/2015)
12/18/2014	<a href="#"><u>3</u></a>	ORDER: Initial Conference set for 2/20/2015 at 11:00 AM before Judge Katherine B. Forrest as further set forth in this order. (Signed by Judge Katherine B. Forrest on 12/18/2014) (lmb) (Entered: 12/19/2014)
12/30/2014	<a href="#"><u>4</u></a>	RULE 7.1 CORPORATE DISCLOSURE STATEMENT. Identifying Corporate Parent Bell Canada, Corporate Parent BCE, Inc. for Bell Media Inc.. Document filed by Bell Media Inc..(McNamara, Elizabeth) (Entered: 12/30/2014)
12/30/2014	<a href="#"><u>5</u></a>	RESPONSE <i>Request for Extension of Time to Respond to the Complaint.</i> Document filed by Bell Media Inc.. (McNamara, Elizabeth) (Entered: 12/30/2014)
12/31/2014	<a href="#"><u>6</u></a>	BRIEF re: <a href="#"><u>5</u></a> <i>Response in opposition to request for extension of time.</i> Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. (Attachments: # <a href="#"><u>1</u></a> Exhibit Exhibit A (proof of service))(Dowd, Raymond) (Entered: 12/31/2014)

12/31/2014	<a href="#">7</a>	MEMO ENDORSEMENT on re: <a href="#">5</a> Response filed by Bell Media Inc. ENDORSEMENT: SO ORDERED. The initial pre-trial conference scheduled for February 20, 2014 at 11:00 a.m. remains in place. Bell Media Inc. answer due 1/29/2015. (Signed by Judge Katherine B. Forrest on 12/31/2014) (tn) (Entered: 12/31/2014)
01/05/2015	<a href="#">8</a>	LETTER MOTION for Extension of Time to File Answer re: <a href="#">5</a> Response addressed to Judge Katherine B. Forrest from Elizabeth A. McNamara dated January 5, 2015. Document filed by Bell Media Inc..(McNamara, Elizabeth) (Entered: 01/05/2015)
01/07/2015	<a href="#">9</a>	ORDER: As set forth during the telephonic conference on Tuesday, January 6, 2015 at 3:00 p.m.: 1. Not later than Friday, January 9, 2015, plaintiff shall submit a letter on ECF indicating whether plaintiff will amend its complaint to include new defendants, and if so, what new defendants will be named. Any such amendment must be filed not later than Thursday, January 29, 2015. 2. Defendant shall file any motion to dismiss not later than Thursday, January 29, 2015. At this time, as appropriate, the parties shall engage in targeted jurisdictional discovery. Plaintiff's opposition shall be due Monday, March 16, 2015. Defendant's reply shall be due Monday, March 30, 2015. 3. The initial pre-trial conference currently scheduled for Friday, February 20, 2015 at 11:00 a.m. is hereby rescheduled to Tuesday, March 31, 2015 at 1:00 p.m., ( Amended Pleadings due by 1/29/2015., Motions due by 1/29/2015., Responses due by 3/16/2015., Replies due by 3/30/2015.), ( Initial Conference set for 3/31/2015 at 01:00 PM before Judge Katherine B. Forrest.) (Signed by Judge Katherine B. Forrest on 1/6/2015) (lmb) Modified on 1/8/2015 (lmb). (Entered: 01/07/2015)
01/08/2015	<a href="#">10</a>	FIRST LETTER addressed to Judge Katherine B. Forrest from Raymond J. Dowd dated 1/8/2015 re: Amending Complaint. Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH.(Dowd, Raymond) (Entered: 01/08/2015)
01/13/2015	<a href="#">11</a>	NOTICE OF APPEARANCE by Linda Jane Steinman on behalf of Bell Media Inc.. (Steinman, Linda) (Entered: 01/13/2015)
01/13/2015	<a href="#">12</a>	ORDER. In light of plaintiff's representation that they intend to amend the Complaint in this action (ECF No. 10), the schedule in this action is hereby modified as follows: 1. Plaintiff shall file their amended complaint not later than Thursday, January 29, 2015. 2. Defendant shall file any motion to dismiss not later than Friday, February 20, 2015. At this time, as appropriate, the parties shall engage in targeted jurisdictional discovery. Plaintiff's opposition shall be due Friday, March 27, 2015. Defendant's reply shall be due Friday, April 10, 2015. 3. The initial pre-trial conference currently scheduled for Tuesday, March 31, 2015 at 1:00 p.m. is hereby rescheduled to Tuesday, April 21, 2015 at 1:00 p.m. The Clerk of Court is directed to close the motion at ECF No. 8. SO ORDERED. Terminating <a href="#">8</a> LETTER MOTION for Extension of Time to File Answer re: <a href="#">5</a> Response addressed to Judge Katherine B. Forrest from Elizabeth A. McNamara dated January 5, 2015. (Signed by Judge Katherine B. Forrest on 1/13/2015) (rjm) (Entered: 01/14/2015)

01/13/2015		Set/Reset Deadlines: Amended Pleadings due by 1/29/2015. Motions due by 2/20/2015. Responses due by 3/27/2015. Replies due by 4/10/2015. (rjm) (Entered: 01/14/2015)
01/13/2015		Set/Reset Hearings: Initial Conference set for 4/21/2015 at 01:00 PM before Judge Katherine B. Forrest. (rjm) (Entered: 01/14/2015)
01/21/2015	<a href="#">13</a>	FIRST AMENDED COMPLAINT amending <a href="#">1</a> Complaint, against Bell Media Inc., Bigfoot Media, Inc. with JURY DEMAND. Document filed by Fashion TV Programmgesellschaft MbH, F. Tv Ltd.. Related document: <a href="#">1</a> Complaint, filed by Fashion TV Programmgesellschaft MbH, F. Tv Ltd.. (Attachments: # <a href="#">1</a> Exhibit SJ Order, # <a href="#">2</a> Exhibit Order after trial, # <a href="#">3</a> Exhibit Gleissner profile, # <a href="#">4</a> Exhibit FTIL filing, # <a href="#">5</a> Exhibit 2005 Memorandum of Understanding (redacted), # <a href="#">6</a> Exhibit Bigfoot NY address, # <a href="#">7</a> Exhibit Atlantic Broadband indemnification request, # <a href="#">8</a> Exhibit Google Analytics, # <a href="#">9</a> Exhibit Google Analytics, # <a href="#">10</a> Exhibit 2005 letter, # <a href="#">11</a> Exhibit FTA PTE LTD filing, # <a href="#">12</a> Exhibit Bird and Bird letter, # <a href="#">13</a> Exhibit 2010 letter, # <a href="#">14</a> Exhibit Dec 2014 letter)(Dowd, Raymond) (Entered: 01/21/2015)
01/21/2015	<a href="#">14</a>	REQUEST FOR ISSUANCE OF SUMMONS as to Bigfoot Entertainment, Inc., re: <a href="#">13</a> Amended Complaint,,, Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. (Dowd, Raymond) (Entered: 01/21/2015)
01/23/2015	<a href="#">15</a>	ELECTRONIC SUMMONS ISSUED as to Bigfoot Media, Inc. (lcu) (Entered: 01/23/2015)
02/12/2015	<a href="#">16</a>	LETTER MOTION for Leave to File Excess Pages addressed to Judge Katherine B. Forrest from Elizabeth A. McNamara dated February 12, 2015. Document filed by Bell Media Inc..(McNamara, Elizabeth) (Entered: 02/12/2015)
02/13/2015	<a href="#">17</a>	ORDER granting <a href="#">16</a> Letter Motion for Leave to File Excess Pages. So ordered. (Signed by Judge Katherine B. Forrest on 2/13/2015) (spo) (Entered: 02/13/2015)
02/17/2015	<a href="#">18</a>	LETTER MOTION for Extension of Time to File Answer re: <a href="#">13</a> Amended Complaint,,, addressed to Judge Katherine B. Forrest from Mark Lerner dated February 17, 2015. Document filed by Bigfoot Entertainment, Inc..(Lerner, Mark) (Entered: 02/17/2015)
02/17/2015	<a href="#">19</a>	LETTER RESPONSE in Opposition to Motion addressed to Judge Katherine B. Forrest from Raymond Dowd dated February 17, 2015 re: <a href="#">18</a> LETTER MOTION for Extension of Time to File Answer re: <a href="#">13</a> Amended Complaint,,, addressed to Judge Katherine B. Forrest from Mark Lerner dated February 17, 2015. . Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. (Attachments: # <a href="#">1</a> Exhibit Exhibit 1 - Aff Of Service)(Dowd, Raymond) (Entered: 02/17/2015)
02/18/2015	<a href="#">20</a>	ORDER granting <a href="#">18</a> Letter Motion for Extension of Time to Answer. The Court grants the extension per the schedule above. However, the Court notes Plaintiffs' objection to such extension and notes further that the basis for such objections are reasonable. Nevertheless, the extension is granted as allowing resolution in the original overall time frame. (Bigfoot Entertainment, Inc. answer due

		3/2/2015) (Signed by Judge Katherine B. Forrest on 2/18/2015) (spo) (Entered: 02/18/2015)
02/18/2015		Set/Reset Deadlines: Motions due by 3/2/2015. Responses due by 4/1/2015. Replies due by 4/15/2015. (spo) (Entered: 02/18/2015)
02/19/2015	<a href="#">21</a>	LETTER addressed to Judge Katherine B. Forrest from Elizabeth A. McNamara dated 02/19/2015 re: Clarification of docket entry with respect to scheduling. Document filed by Bell Media Inc..(McNamara, Elizabeth) (Entered: 02/19/2015)
02/19/2015	<a href="#">22</a>	MEMO ENDORSEMENT on re: <a href="#">21</a> Letter requesting clarification of schedule, filed by Bell Media Inc. ENDORSEMENT: Yes. (Signed by Judge Katherine B. Forrest on 2/19/2015) (spo) (Entered: 02/19/2015)
03/02/2015	<a href="#">23</a>	RULE 7.1 CORPORATE DISCLOSURE STATEMENT. No Corporate Parent. Document filed by Bigfoot Entertainment, Inc..(Lerner, Mark) (Entered: 03/02/2015)
03/02/2015	<a href="#">24</a>	MOTION to Dismiss <i>the Amended Complaint</i> . Document filed by Bigfoot Entertainment, Inc..(Lerner, Mark) (Entered: 03/02/2015)
03/02/2015	<a href="#">25</a>	MEMORANDUM OF LAW in Support re: <a href="#">24</a> MOTION to Dismiss <i>the Amended Complaint</i> . . Document filed by Bigfoot Entertainment, Inc.. (Lerner, Mark) (Entered: 03/02/2015)
03/02/2015	<a href="#">26</a>	AFFIDAVIT of Mark Lerner in Support re: <a href="#">24</a> MOTION to Dismiss <i>the Amended Complaint</i> .. Document filed by Bigfoot Entertainment, Inc.. (Attachments: # <a href="#">1</a> Exhibit A, # <a href="#">2</a> Exhibit B)(Lerner, Mark) (Entered: 03/02/2015)
03/02/2015	<a href="#">27</a>	NOTICE OF APPEARANCE by Jennifer Philbrick McArdle on behalf of Bigfoot Entertainment, Inc.. (McArdle, Jennifer) (Entered: 03/02/2015)
03/02/2015	<a href="#">28</a>	MOTION to Dismiss <i>the First Amended Complaint</i> . Document filed by Bell Media Inc..(McNamara, Elizabeth) (Entered: 03/02/2015)
03/02/2015	<a href="#">29</a>	MEMORANDUM OF LAW in Support re: <a href="#">28</a> MOTION to Dismiss <i>the First Amended Complaint</i> . . Document filed by Bell Media Inc.. (McNamara, Elizabeth) (Entered: 03/02/2015)
03/02/2015	<a href="#">30</a>	DECLARATION of Kevin A. Assaff in Support re: <a href="#">28</a> MOTION to Dismiss <i>the First Amended Complaint</i> .. Document filed by Bell Media Inc.. (Attachments: # <a href="#">1</a> Exhibit A, # <a href="#">2</a> Exhibit B, # <a href="#">3</a> Exhibit C, # <a href="#">4</a> Exhibit D, # <a href="#">5</a> Exhibit E, # <a href="#">6</a> Exhibit F)(McNamara, Elizabeth) (Entered: 03/02/2015)
03/02/2015	<a href="#">31</a>	DECLARATION of Elizabeth A. McNamara in Support re: <a href="#">28</a> MOTION to Dismiss <i>the First Amended Complaint</i> .. Document filed by Bell Media Inc.. (Attachments: # <a href="#">1</a> Exhibit 1, # <a href="#">2</a> Exhibit 2, # <a href="#">3</a> Exhibit 3, # <a href="#">4</a> Exhibit 4, # <a href="#">5</a> Exhibit 5, # <a href="#">6</a> Exhibit 6, # <a href="#">7</a> Exhibit 7, # <a href="#">8</a> Exhibit 8, # <a href="#">9</a> Exhibit 9, # <a href="#">10</a> Exhibit 10, # <a href="#">11</a> Exhibit 11, # <a href="#">12</a> Exhibit 12)(McNamara, Elizabeth) (Entered: 03/02/2015)

03/02/2015	<a href="#"><u>32</u></a>	NOTICE OF APPEARANCE by Alison Brooke Schary on behalf of Bell Media Inc.. (Schary, Alison) (Entered: 03/02/2015)
03/17/2015	<a href="#"><u>33</u></a>	LETTER addressed to Judge Katherine B. Forrest from Mark Lerner dated March 17, 2015 Document filed by Bigfoot Entertainment, Inc.. (Attachments: # <a href="#"><u>1</u></a> Exhibit A and B)(Lerner, Mark) (Entered: 03/17/2015)
03/18/2015	<a href="#"><u>34</u></a>	LETTER addressed to Judge Katherine B. Forrest from Raymond Dowd dated March 18, 2015 re: Response to Bigfoot's request for a protective order. Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. (Attachments: # <a href="#"><u>1</u></a> Exhibit Ex. 1)(Dowd, Raymond) (Entered: 03/18/2015)
03/20/2015	<a href="#"><u>35</u></a>	LETTER addressed to Judge Katherine B. Forrest from Raymond Dowd dated March 20, 2015 re: Response to Mr. Zissu's 3/19/15 letter re: subpoena to David Donahue of Fross Zelnick. Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH.(Dowd, Raymond) (Entered: 03/20/2015)
03/23/2015	<a href="#"><u>36</u></a>	ENDORSED LETTER addressed to Judge Katherine B. Forrest from Samuel Blaustein dated 3/20/2015 re: Email attaching letter in opposition to the letter submitted by Mr. Roger Zissu concerning the subpoena issued to Mr. David Donahue and request to extend the time to file its opposition to Defendants' motion to dismiss. ENDORSEMENT: The Court does not take emails on substantive matters or accept "stips." Please see my Individual Rules. (Signed by Judge Katherine B. Forrest on 3/23/2015) (kko) (Entered: 03/23/2015)
03/23/2015	<a href="#"><u>37</u></a>	ENDORSED LETTER addressed to Judge Katherine B. Forrest from Roger L. Zissu dated 3/20/2015 re: To advise your Honor that on behalf of my partner, David Donahue, who is a third party recipient of a deposition subpoena, I caused to be filed a letter to quash that subpoena. ENDORSEMENT: Please do not send emails with any substantive content. (Signed by Judge Katherine B. Forrest on 3/23/2015) (kko) (Entered: 03/23/2015)
03/23/2015	<a href="#"><u>38</u></a>	ENDORSED LETTER addressed to Judge Katherine B. Forrest from Roger L. Zissu dated 3/19/2015 re: Request that the Court quash a subpoena directed to David Donahue and impose sanctions on Plaintiffs and their counsel. ENDORSEMENT: This letter needs to be filed on ECF. The issue is in any event moot per March 20 letter from Mr. Dowd. Renew if necessary. (Signed by Judge Katherine B. Forrest on 3/23/2015) (kko) (Entered: 03/23/2015)
03/25/2015	<a href="#"><u>39</u></a>	FIRST LETTER MOTION for Extension of Time to File Response/Reply as to <a href="#"><u>28</u></a> MOTION to Dismiss <i>the First Amended Complaint.</i> , <a href="#"><u>24</u></a> MOTION to Dismiss <i>the Amended Complaint.</i> addressed to Judge Katherine B. Forrest from Samuel Blaustein dated March 25, 2015. Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. Return Date set for 4/8/2015 at 12:00 AM.(Blaustein, Samuel) (Entered: 03/25/2015)
03/26/2015	<a href="#"><u>40</u></a>	ORDER granting <a href="#"><u>39</u></a> Letter Motion for Extension of Time to File Response/Reply. The schedule is adjusted as follows: Opposition briefs are due not later than April 8, 2015. Reply briefs are due not later than April 29, 2015. The IPTC is rescheduled to Friday, May 1, 2015 at 3:00pm. Responses due by 4/8/2015. Replies due by 4/29/2015. (Signed by Judge Katherine B. Forrest on



		3/26/2015) (lmb) (Entered: 03/26/2015)
03/26/2015		Set/Reset Hearings: Initial Conference set for 5/1/2015 at 03:00 PM before Judge Katherine B. Forrest. (lmb) (Entered: 03/26/2015)
04/02/2015	<a href="#">41</a>	<b>FILING ERROR - WRONG EVENT TYPE SELECTED FROM MENU - FIRST LETTER MOTION</b> for Local Rule 37.2 Conference <i>concerning jurisdictional discovery</i> addressed to Judge Katherine B. Forrest from Raymond Dowd dated April 2, 2015. Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. (Attachments: # <a href="#">1</a> Exhibit Exhibits A-F)(Dowd, Raymond) Modified on 4/3/2015 (ldi). (Entered: 04/02/2015)
04/02/2015	<a href="#">42</a>	<b>FILING ERROR - WRONG EVENT TYPE SELECTED FROM MENU - SECOND MOTION</b> to Quash Subpoena of David Donahue . Document filed by Fross Zelnick Lehrman & Zissu, P.C..(Zissu, Roger) Modified on 4/3/2015 (ldi). (Entered: 04/02/2015)
04/03/2015		<b>***NOTICE TO ATTORNEY TO RE-FILE DOCUMENT - EVENT TYPE ERROR. Notice to Attorney Raymond James Dowd to RE-FILE Document <a href="#">41</a> FIRST LETTER MOTION for Local Rule 37.2 Conference concerning jurisdictional discovery addressed to Judge Katherine B. Forrest from Raymond Dowd dated April 2, 2015.. Use the event type Letter found under the event list Other Documents. (ldi)</b> (Entered: 04/03/2015)
04/03/2015		<b>***NOTICE TO ATTORNEY TO RE-FILE DOCUMENT - EVENT TYPE ERROR. Notice to Attorney Roger L. Zissu to RE-FILE Document <a href="#">42</a> SECOND MOTION to Quash Subpoena of David Donahue . Use the event type Letter found under the event list Other Documents. (ldi)</b> (Entered: 04/03/2015)
04/03/2015	<a href="#">43</a>	SECOND LETTER addressed to Judge Katherine B. Forrest from Roger L. Zissu dated 04/02/2015 re: Request to Quash David Donahue, Esq. Subpoena. Document filed by Fross Zelnick Lehrman & Zissu, P.C..(Zissu, Roger) (Entered: 04/03/2015)
04/06/2015	<a href="#">44</a>	LETTER addressed to Judge Katherine B. Forrest from Raymond Dowd dated April 2, 2015 re: Jurisdictional Discovery. Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. (Attachments: # <a href="#">1</a> Exhibit Exs A-F)(Dowd, Raymond) (Entered: 04/06/2015)
04/06/2015	<a href="#">45</a>	LETTER addressed to Judge Katherine B. Forrest from Raymond Dowd dated April 6, 2015 re: Opposition to FZLZ motion to quash. Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH.(Dowd, Raymond) (Entered: 04/06/2015)
04/06/2015	<a href="#">46</a>	LETTER addressed to Judge Katherine B. Forrest from Mark Lerner dated April 6, 2015 re: opposition to Plaintiffs' motion to compel. Document filed by Bigfoot Entertainment, Inc.. (Attachments: # <a href="#">1</a> Exhibit A)(Lerner, Mark) (Entered: 04/06/2015)
04/06/2015	<a href="#">47</a>	LETTER addressed to Judge Katherine B. Forrest from Elizabeth A. McNamara dated 04/06/2015 re: Opposition to Plaintiff's Motion to Compel. Document filed

		by Bell Media Inc.. (Attachments: # <a href="#">1</a> Exhibit A, # <a href="#">2</a> Exhibit B)(McNamara, Elizabeth) (Entered: 04/06/2015)
04/06/2015	<a href="#">48</a>	<b>FILING ERROR - WRONG EVENT TYPE SELECTED FROM MENU - RESPONSE</b> re: <a href="#">44</a> Letter . Document filed by Fross Zelnick Lehrman & Zissu, P.C.. (Zissu, Roger) Modified on 4/7/2015 (db). (Entered: 04/06/2015)
04/07/2015		<b>***NOTICE TO ATTORNEY TO RE-FILE DOCUMENT - EVENT TYPE ERROR. Notice to Attorney Roger L. Zissu to RE-FILE Document <a href="#">48</a> Response. Use the event type Letter found under the event list Other Documents. (db)</b> (Entered: 04/07/2015)
04/07/2015	<a href="#">49</a>	LETTER addressed to Judge Katherine B. Forrest from Roger L. Zissu dated 04/06/2015 re: Opposition to <a href="#">44</a> Jurisdictional Discovery filed by Plaintiffs F. Tv Ltd., and Fashion TV Programmgesellschaft MbH. Document filed by Fross Zelnick Lehrman & Zissu, P.C..(Zissu, Roger) (Entered: 04/07/2015)
04/07/2015	<a href="#">50</a>	MEMO ENDORSEMENT on re: <a href="#">45</a> Letter filed by Fashion TV Programmgesellschaft MbH, F. Tv Ltd. ENDORSEMENT: This is the last discovery from FZLZ at this time: they shall answer the above question -- no documents or other information on this question is required until further order from this Court. One week to answer. (Signed by Judge Katherine B. Forrest on 4/7/2015) (lmb) (Entered: 04/07/2015)
04/07/2015	<a href="#">51</a>	MEMO ENDORSEMENT on re: <a href="#">46</a> Letter filed by Bigfoot Entertainment, Inc. ENDORSEMENT: Agreed that communications about cease and desist letters need not be produced at this time as they shall likely be privileged. Agreed also that materials post-dating matters in the FAC are not relevant to the jurisdictional issue right now before the Court. Motion to compel denied as to Bigfoot. (Signed by Judge Katherine B. Forrest on 4/7/2015) (lmb) (Entered: 04/07/2015)
04/07/2015	<a href="#">52</a>	MEMO ENDORSEMENT on re: <a href="#">47</a> Letter, filed by Bell Media Inc. ENDORSEMENT: Motion to compel granted with discovery to be further worked out. The Court understands that Bell will argue that its contacts with N.Y. -- either directly or via an agent -- are insufficient to support jurisdiction. In order to assess whether that is the case, however, some development of the factual record regarding licensing arrangements in N.Y. or via N.Y. and its agent -- relationship in N.Y. must be explored. Work out additional discovery to provide the parameters of that -- substantive details of licensing are unnecessary to disclose at this time. (Signed by Judge Katherine B. Forrest on 4/7/2015) (lmb) (Entered: 04/07/2015)
04/08/2015	<a href="#">53</a>	<b>FILING ERROR - DEFICIENT DOCKET ENTRY - CROSS MOTION</b> for Declaratory Judgment <i>pursuant to Rule 12(c) and to supplement pursuant to Rule 15(d)</i> . Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. Responses due by 4/29/2015 (Attachments: # <a href="#">1</a> Affidavit Dowd Declaration, # <a href="#">2</a> Exhibit ftv results, # <a href="#">3</a> Exhibit fashiontv results, # <a href="#">4</a> Exhibit DISH FTV, # <a href="#">5</a> Exhibit TESS results, # <a href="#">6</a> Exhibit OHIM, # <a href="#">7</a> Exhibit Charim Dec, # <a href="#">8</a> Exhibit FTV March 11 letter, # <a href="#">9</a> Exhibit Bell Objection Letter, # <a href="#">10</a> Exhibit Assignment, # <a href="#">11</a> Exhibit Formal Objections, # <a href="#">12</a> Exhibit Assaff Depo, # <a href="#">13</a> Exhibit Retainer, # <a href="#">14</a> Exhibit Invoice, # <a href="#">15</a> Exhibit Dudek Aff, # <a href="#">16</a> Exhibit



		FZLZ email, # <a href="#">17</a> Exhibit Adjmi case, # <a href="#">18</a> Exhibit WIPO, # <a href="#">19</a> Exhibit Judgment)(Dowd, Raymond) Modified on 4/9/2015 (db). (Entered: 04/08/2015)
04/08/2015	<a href="#">54</a>	<b>FILING ERROR - DEFICIENT DOCKET ENTRY</b> - MEMORANDUM OF LAW in Opposition re: <a href="#">28</a> MOTION to Dismiss <i>the First Amended Complaint.</i> , <a href="#">24</a> MOTION to Dismiss <i>the Amended Complaint.</i> , <a href="#">53</a> CROSS MOTION for Declaratory Judgment <i>pursuant to Rule 12(c) and to supplement pursuant to Rule 15(d).</i> . Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. (Dowd, Raymond) Modified on 4/9/2015 (db). (Entered: 04/08/2015)
04/09/2015		<b>***NOTICE TO ATTORNEY TO RE-FILE DOCUMENT - DEFICIENT DOCKET ENTRY ERROR. Notice to Attorney Raymond James Dowd to RE-FILE Document <a href="#">53</a> CROSS MOTION for Declaratory Judgment pursuant to Rule 12(c) and to supplement pursuant to Rule 15(d). ERROR(S): Supporting Documents are filed separately, each receiving their own document #. (db)</b> (Entered: 04/09/2015)
04/09/2015		<b>***NOTICE TO ATTORNEY TO RE-FILE DOCUMENT - DEFICIENT DOCKET ENTRY ERROR. Notice to Attorney Raymond James Dowd to RE-FILE Document <a href="#">54</a> Memorandum of Law in Opposition to Motion. ERROR(S): Document linked to filing error. (db)</b> (Entered: 04/09/2015)
04/09/2015	<a href="#">55</a>	CROSS MOTION for Declaratory Judgment <i>and to supplement.</i> Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. Responses due by 4/29/2015(Dowd, Raymond) (Entered: 04/09/2015)
04/09/2015	<a href="#">56</a>	DECLARATION of Raymond J. Dowd in Support re: <a href="#">28</a> MOTION to Dismiss <i>the First Amended Complaint.</i> , <a href="#">24</a> MOTION to Dismiss <i>the Amended Complaint.</i> , <a href="#">55</a> CROSS MOTION for Declaratory Judgment <i>and to supplement.</i> Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. (Attachments: # <a href="#">1</a> Exhibit ftv.com, # <a href="#">2</a> Exhibit fashiontv.com, # <a href="#">3</a> Exhibit DISH FTV, # <a href="#">4</a> Exhibit TESS results, # <a href="#">5</a> Exhibit OHIM cancellation, # <a href="#">6</a> Exhibit Charim Dec, # <a href="#">7</a> Exhibit March 11 letter, # <a href="#">8</a> Exhibit Bell objection letter, # <a href="#">9</a> Exhibit Assignment, # <a href="#">10</a> Exhibit Bell objection, # <a href="#">11</a> Exhibit Assaff depo, # <a href="#">12</a> Exhibit Engagement letter, # <a href="#">13</a> Exhibit FZLZ invoice, # <a href="#">14</a> Exhibit Dudek Aff, # <a href="#">15</a> Exhibit FZLZ email, # <a href="#">16</a> Exhibit Adjmi Case, # <a href="#">17</a> Exhibit WIPO Complaint, # <a href="#">18</a> Exhibit Judgment)(Dowd, Raymond) (Entered: 04/09/2015)
04/09/2015	<a href="#">57</a>	MEMORANDUM OF LAW in Opposition re: <a href="#">28</a> MOTION to Dismiss <i>the First Amended Complaint.</i> , <a href="#">24</a> MOTION to Dismiss <i>the Amended Complaint.</i> , <a href="#">55</a> CROSS MOTION for Declaratory Judgment <i>and to supplement.</i> . Document filed by Fashion TV Programmgesellschaft MbH. (Dowd, Raymond) (Entered: 04/09/2015)
04/09/2015		<b>***STRICKEN DOCUMENT. Deleted document number [56-11] from the case record. The document was stricken from this case pursuant to <a href="#">77</a> Memo Endorsement. (lmb)</b> (Entered: 05/14/2015)
04/10/2015	<a href="#">58</a>	LETTER addressed to Judge Katherine B. Forrest from Samuel Blaustein dated April 10, 2015 re: Courtesy Copies of Cross-Moving and Opposition Papers. Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft

		MbH.(Blaustein, Samuel) (Entered: 04/10/2015)
04/10/2015	<a href="#">59</a>	ORDER: In light of plaintiffs' motion for leave to supplement its Amended Complaint pursuant to Rule 15(d) and for a declaratory judgment on the pleadings pursuant to Rule 12(c), the Court issues this order to clarify that the schedule for briefing the pending motions shall be as follows: Reply / cross-motions opposition: due not later than April 29, 2015. Cross-motions reply: due not later than May 6, 2015. Set Deadlines/Hearing as to <a href="#">24</a> MOTION to Dismiss <i>the Amended Complaint</i> , <a href="#">28</a> MOTION to Dismiss <i>the First Amended Complaint</i> , <a href="#">55</a> CROSS MOTION for Declaratory Judgment <i>and to supplement</i> : (Replies due by 4/29/2015. Responses due by 4/29/2015, Replies due by 5/6/2015.) (Signed by Judge Katherine B. Forrest on 4/10/2015) (kko) (Entered: 04/10/2015)
04/16/2015	<a href="#">60</a>	LETTER addressed to Judge Katherine B. Forrest from Samuel Blaustein dated April 16, 2015 re: Conference Scheduling. Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH.(Blaustein, Samuel) (Entered: 04/16/2015)
04/21/2015	<a href="#">61</a>	MEMO ENDORSEMENT on re: <a href="#">60</a> Letter filed by Fashion TV Programmgesellschaft MbH, F. Tv Ltd. ENDORSEMENT: ORDERED: Conference rescheduled to 5-28-15 AT 9:00 A.M. ( Initial Conference set for 5/28/2015 at 09:00 AM before Judge Katherine B. Forrest.) (Signed by Judge Katherine B. Forrest on 4/17/2015) (ama) (Entered: 04/21/2015)
04/21/2015	<a href="#">62</a>	ENDORSED LETTER addressed to Judge Katherine B. Forrest from Elizabeth A. McNamara dated 3/2/2015 re: Enclosing courtesy copies of Defendant Bell Media Inc.'s filing via ECF of Notice of Motion to Dismiss the First Amended Complaint and supporting documents. ENDORSEMENT: Post to docket. (Signed by Judge Katherine B. Forrest on 4/17/2015) (kko) (Entered: 04/21/2015)
04/29/2015	<a href="#">63</a>	REPLY MEMORANDUM OF LAW in Support re: <a href="#">24</a> MOTION to Dismiss <i>the Amended Complaint. and in Opposition to Plaintiffs' Cross-Motion for a Declaratory Judgment and Leave to Supplement</i> . Document filed by Bigfoot Entertainment, Inc.. (Lerner, Mark) (Entered: 04/29/2015)
04/29/2015	<a href="#">64</a>	REPLY to Response to Motion re: <a href="#">28</a> MOTION to Dismiss <i>the First Amended Complaint.</i> , <a href="#">55</a> CROSS MOTION for Declaratory Judgment <i>and to supplement.</i> . Document filed by Bell Media Inc.. (McNamara, Elizabeth) (Entered: 04/29/2015)
04/29/2015	<a href="#">65</a>	REPLY AFFIDAVIT of Kevin A. Assaff in Support re: <a href="#">28</a> MOTION to Dismiss <i>the First Amended Complaint.</i> . Document filed by Bell Media Inc.. (Attachments: # <a href="#">1</a> Exhibit 1, # <a href="#">2</a> Exhibit 2)(McNamara, Elizabeth) (Entered: 04/29/2015)
04/29/2015	<a href="#">66</a>	REPLY AFFIDAVIT of Elizabeth A. McNamara in Support re: <a href="#">28</a> MOTION to Dismiss <i>the First Amended Complaint.</i> . Document filed by Bell Media Inc.. (Attachments: # <a href="#">1</a> Exhibit 1, # <a href="#">2</a> Exhibit 2, # <a href="#">3</a> Exhibit 3, # <a href="#">4</a> Exhibit 4, # <a href="#">5</a> Exhibit 5)(McNamara, Elizabeth) (Entered: 04/29/2015)
04/29/2015	<a href="#">67</a>	MOTION to Seal <i>Certain Financial Information Submitted in Support of and in Opposition to Its Motion to Dismiss</i> . Document filed by Bell Media Inc..(McNamara, Elizabeth) (Entered: 04/29/2015)

04/29/2015	<a href="#">68</a>	MEMORANDUM OF LAW in Support re: <a href="#">67</a> MOTION to Seal <i>Certain Financial Information Submitted in Support of and in Opposition to Its Motion to Dismiss.</i> . Document filed by Bell Media Inc.. (Attachments: # <a href="#">1</a> Proposed Redacted Exhibit)(McNamara, Elizabeth) (Entered: 04/29/2015)
04/30/2015	<a href="#">69</a>	MEMO ENDORSEMENT on re: <a href="#">67</a> MOTION to Seal <i>Certain Financial Information Submitted in Support of and in Opposition to Its Motion to Dismiss.</i> filed by Bell Media Inc. ENDORSEMENT: Plaintiff to file any opposition within one week. No replies. (Signed by Judge Katherine B. Forrest on 4/30/2015) (lmb) (Entered: 04/30/2015)
05/06/2015	<a href="#">70</a>	DECLARATION of Raymond J. Dowd in Support re: <a href="#">55</a> CROSS MOTION for Declaratory Judgment <i>and to supplement.</i> . Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. (Attachments: # <a href="#">1</a> Exhibit Bigfoot Objections, # <a href="#">2</a> Exhibit Screen Shot Fashion Television, # <a href="#">3</a> Exhibit Screen Shot Fashion Television, # <a href="#">4</a> Exhibit Screen Shot Fashion Television, # <a href="#">5</a> Exhibit Screen Shot Server Location)(Dowd, Raymond) (Entered: 05/06/2015)
05/06/2015	<a href="#">71</a>	REPLY MEMORANDUM OF LAW in Support re: <a href="#">55</a> CROSS MOTION for Declaratory Judgment <i>and to supplement.</i> . Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. (Dowd, Raymond) (Entered: 05/06/2015)
05/07/2015	<a href="#">72</a>	DECLARATION of Samuel Blaustein in Opposition re: <a href="#">67</a> MOTION to Seal <i>Certain Financial Information Submitted in Support of and in Opposition to Its Motion to Dismiss.</i> . Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. (Attachments: # <a href="#">1</a> Exhibit Email re Confidentiality, # <a href="#">2</a> Exhibit Email re Depo, # <a href="#">3</a> Exhibit Email re Request for Protective Order) (Blaustein, Samuel) (Entered: 05/07/2015)
05/07/2015	<a href="#">73</a>	MEMORANDUM OF LAW in Opposition re: <a href="#">67</a> MOTION to Seal <i>Certain Financial Information Submitted in Support of and in Opposition to Its Motion to Dismiss.</i> . Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH. (Blaustein, Samuel) (Entered: 05/07/2015)
05/07/2015		<b>***STRICKEN DOCUMENT. Deleted document number [72-3] from the case record. The document was stricken from this case pursuant to 77 Memo Endorsement. (lmb)</b> Modified on 5/14/2015 (lmb). (Entered: 05/14/2015)
05/08/2015	<a href="#">74</a>	LETTER addressed to Judge Katherine B. Forrest from Samuel Blaustein dated May 8, 2015 re: Courtesy Copies. Document filed by F. Tv Ltd., Fashion TV Programmgesellschaft MbH.(Blaustein, Samuel) (Entered: 05/08/2015)
05/11/2015	<a href="#">75</a>	MEMO ENDORSEMENT on re: <a href="#">73</a> Memorandum of Law in Opposition to Motion, filed by Fashion TV Programmgesellschaft MbH, F. Tv Ltd. ENDORSEMENT: Bell's motion to redact is granted. The company has shown good cause as to why the redactions are necessary and appropriate. The public may still have fair access to all key information in this case (irrespective of the redactions). (Signed by Judge Katherine B. Forrest on 5/11/2015) (lmb) (Entered: 05/11/2015)

05/13/2015	<a href="#">76</a>	LETTER addressed to Judge Katherine B. Forrest from Elizabeth A. McNamara dated May 13, 2015 re: Redactions Granted By Court's May 11, 2015 Order. Document filed by Bell Media Inc.. (Attachments: # <a href="#">1</a> Attachment 1, # <a href="#">2</a> Attachment 2)(McNamara, Elizabeth) (Entered: 05/13/2015)
05/14/2015	<a href="#">77</a>	MEMO ENDORSEMENT on re: <a href="#">76</a> Letter, filed by Bell Media Inc. ENDORSEMENT: The Clerk of Court to remove the documents at ECF Nos. 56-11, 72-3. Those documents may now be found at ECF No. 76. (Signed by Judge Katherine B. Forrest on 5/14/2015) (lmb) (Entered: 05/14/2015)
05/14/2015	<a href="#">78</a>	OPINION & ORDER re: <a href="#">28</a> MOTION to Dismiss <i>the First Amended Complaint</i> . filed by Bell Media Inc. For the reasons set forth above, Bell's motion to dismiss is GRANTED. The Clerk of Court is directed to close the motion at ECF No. 28., Bell Media Inc. (a Canadian corporation, as successor-in-interest to Chum Limited, a Canadian Corporation) terminated. (Signed by Judge Katherine B. Forrest on 5/14/2015) (lmb) (Entered: 05/14/2015)
05/14/2015	<a href="#">79</a>	ORDER denying <a href="#">55</a> Motion for Declaratory Judgment; denying <a href="#">24</a> Motion to Dismiss. In light of the mismatch between the First Amended Complaint and the record on this motion, the Court will allow plaintiffs one final opportunity to amend their complaint. Any amendment may not include Bell as a party, as the Court has dismissed Bell and does not intend to reconsider that decision as further set forth in this order. Plaintiffs must serve and file any second amended complaint within 14 days. The Court will not extend that date. In light of the Court's determination as set forth herein, the motions at ECF Nos. 24 and 55 are DENIED as moot. The Clerk of Court is directed to close the motions at ECF Nos. 24 and 55. (Signed by Judge Katherine B. Forrest on 5/14/2015) (lmb) (Entered: 05/14/2015)

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<b>Description:</b>	Docket Report	<b>Search Criteria:</b>	1:14-cv-09856-KBF
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December 5, 2014

## BY FEDEX

FASHION TV Programmgesellschaft mbH  
 Wasagasse 4  
 Wien, A-1090  
 AUSTRIA

Re: Infringement of FASHION TELEVISION Mark (Our Ref.: BIGF 1409881)

## To Whom It May Concern:

We represent Fashion International Television Ltd., a leading provider of high-quality programming relating to the world of fashion. Under a license emanating from Bell Media Inc. ("Bell Media"), our client has the right to use the FASHION TELEVISION mark and the FT FASHION TELEVISION (and design) mark in the United States and numerous other jurisdictions throughout the world. The licensed rights include, without limitation, the right to use and enforce rights in Bell Media's incontestable registered FT FASHION TELEVISION (and design) mark (U.S. Reg. No. 2,945,407) in connection with "broadcasting programs via a global computer network" and "production and distribution of television programs; and entertainment services in the nature of an ongoing series of television programs concerning commentary, news, history and personalities in the fields of fashion, design trends, photography, art, architecture, music, pop culture, and dance." The registration has a priority date of April 17, 1996 and is based on first use of the mark in commerce in connection with the identified services at least as early as 1992.

It has come to our client's attention that your company has launched a television network in the United States under the mark FASHION TV nationwide on the Dish Network and in parts of Florida on Atlantic Broadband cable. Moreover, our client has become aware that you are distributing fashion-related programming under the FASHION TV name and mark to consumers in the United States through various other media, including via the internet. Your company's use of a mark that is highly similar to the FASHION TELEVISION and FT FASHION TELEVISION (and design) marks for identical or closely related services to our client's services under those marks constitutes trademark infringement and unfair competition under Sections 32(1) and 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1), 1125(a), and various state laws.

In light of the foregoing, we demand that by **December 12, 2014**, your company immediately stop using the FASHION TV name and mark, or any other colorable imitation of the FASHION TELEVISION and FT FASHION TELEVISION (and design) marks, in connection with any television network or any television or internet programming and related services in the United States.

(F1590666 1 )



FASHION TV Programmgesellschaft mbH  
December 5, 2014  
Page 2

We trust that your company will take all action necessary to prevent further infringement of the FASHION TELEVISION and FT FASHION TELEVISION marks. If your company fails to do so, our client will not hesitate to take any action it deems necessary to protect its rights.

This letter is without waiver of or prejudice to any of our client's rights, claims and remedies, all of which are expressly reserved.

Very truly yours,

A handwritten signature in black ink that reads "David Donahue" followed by a stylized flourish or set of initials.

David Donahue

Cc : Raymond Dowd, Esq. (by FedEx)<sup>1</sup>

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<sup>1</sup> We are sending a copy of this correspondence to Mr. Dowd as a courtesy because we are aware that he has represented your company in relation to certain U.S. trademark matters, albeit concerning a different mark in a different context.

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Jennifer Insley-Pruitt  
Emily Weiss  
Ashford Tucker  
Jessica Meiselman  
Erica Gould  
Matthew Frisbee  
Celadon Whitehurst  
Stacy L. Wu  
Hindy Dym  
Katherine Lyon Dayton  
Maritza C. Schaeffer  
Jeffrey D. Larson\*

December 3, 2014

Bigfoot Entertainment Inc.  
246 West Broadway  
New York, NY 10013  
Attn: Gabriel Miller

[gabriel@fashionone.com](mailto:gabriel@fashionone.com)

Re: Engagement of Fross Zelnick Lehrman & Zissu, P.C. by Bigfoot Entertainment Inc. (Our Ref.: BIGF USA TC-14/09881)

Dear Mr. Miller:

The purpose of this letter is to comply with a rule applicable to all New York lawyers, which became effective on March 4, 2002, and to set forth the terms upon which our firm, Fross Zelnick Lehrman & Zissu, P.C. ("FZLZ"), is prepared to represent Bigfoot Entertainment Inc. and its related entities (hereinafter collectively, "Client" or "you"). We ask that you direct your attention to the portions of this letter which pertain to the services you have requested.

Client is engaging FZLZ to represent it in connection with a potential trademark dispute with Fashion TV Programmgesellschaft mbh, Dish Network and Atlantic Broadband Finance, LLC concerning your FT FASHION TELEVISION mark and related matters (collectively, the "Matters"). This engagement does not, at this point, include representation in court litigation or other adversarial proceedings, which would require a further agreement and retainer.

Assignment of Firm Personnel

I will be primarily responsible for the supervision of Client's Matters, but Client is engaging FZLZ, not me individually. As and when necessary, I will draw upon the talent and expertise of other partners, counsel and associates within the firm, and utilize paralegal and other clerical or legal assistant and clerical staff to handle the Matters.

Legal Fees, Expenses, Billings

For the filing of trademark applications, as well as in connection with certain other administrative actions with the USPTO, we charge a fixed minimum fee for each application or registration. In connection with the filing of trademark applications, the fixed fee includes the basic preparation and filing of the application and reporting these actions to you, placing the applications on our records, reporting the issuance of the registration, and placing it on our maintenance system.

Client will pay for FZLZ's other services not encompassed within the fixed fee arrangement on an hourly, time-charge basis, based upon the following rates: Partners'

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\*admitted in HI only

Bigfoot Entertainment Inc.  
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hourly rates currently range from \$490 to \$675 (my rate is \$545); Counsel rates range from \$480 to \$490; Associate rates range from \$310 to \$435; and legal assistant/paralegal rates range from \$150 to \$330 per hour. The foregoing rates are subject to change, usually in January of each year. Hourly billing will be to the tenth (1/10<sup>th</sup>) of an hour for time spent on Client's Matters. It is important to understand that billable time will include telephone and personal conferences both with Client and firm personnel, legal research, and any time spent on any other tasks related to these matters such as providing preliminary advice on filings and strategies, reporting and responding to Official Actions, contacting the USPTO, reporting publication of the application, proving use and filing extensions to prove use, checking status, following up with Client or others on deadlines, updating our records, and transferring the file if you so request.

Client is responsible for any expenses properly and reasonably incurred on behalf of Client, including reimbursement of all disbursements advanced by FZLZ. Such expenses are likely to include, but are not limited to, filing and other fees paid to the Courts and/or the USPTO and other Trademark Offices, photocopying and facsimile charges, long distance telephone calls, computer research charges, charges for search reports prepared by outside vendors such as Thomson, investigator charges and charges by Washington D.C. associates who perform tasks at our request in the USPTO. Any discounts received by FZLZ for such services will be passed on to Client. Costs exceeding \$1,000.00 may be billed directly, for which Client will make prompt, direct payments to the vendor (e.g., for trademark survey experts).

As is our policy in matters of this kind, we are requesting an initial retainer of \$3,500. **An invoice is enclosed for this purpose.** This retainer is a partial advance against anticipated legal fees and disbursements and must be paid before we begin work on your Matters. In the event that a retainer is requested at a future point, such retainer is required to be paid before FZLZ will proceed with further work on the Matters, and we may require the payment of retainers prior to engaging in certain other work or incurring certain expenses, including in connection with retention of expert trial witnesses. Such retainers are advances against anticipated legal fees and disbursements and must be paid promptly so that FZLZ can work on such Matters. The advance will be applied against any of Client's bills for legal services and disbursements. If a retainer is exhausted prior to the conclusion of the Matters for which it is required, FZLZ reserves the right to request replenishment of the retainer before additional work is performed. In the event of such request, Client agrees to make such replenishment within fourteen (14) days of such request. Any unused portion of a retainer shall be returned to Client promptly upon the conclusion of the Matters or upon the termination or withdrawal of FZLZ from this engagement.

In the event our engagement for Client includes representation in an adversary proceeding in the USPTO, Client should be aware that attorney's fees are borne by each party, regardless of the outcome. In connection with lawsuits, attorney's fees are also



Bigfoot Entertainment Inc.  
December 3, 2014  
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generally borne by each party. While we will make every effort to collect any attorney's fees as may be available under applicable statutes for Client (or resist imposition of such fees against you), Client shall remain obligated to FZLZ for payment, including payment for any part of the fee that may be assessed against the other party to the litigation but remains unpaid by that party, as well as any part of the fee that may not be covered by the award.

In some cases, defense of a lawsuit may be covered by Client's insurance policy. In the event Clients are defendants in a lawsuit, Client should review Client's insurance policies to determine whether the cost of defending the claim, and/or the payment of any recovery if Client is found liable or settles, is covered by Client's insurance.

Itemized invoices of services and disbursements will be sent to Client monthly or when appropriate, to the address above (or such other address as Client requests in writing) with payments to be made within thirty (30) days after the invoice date. If Client has any questions or requests regarding the billing format or any information contained in any invoice or statement, please contact FZLZ promptly so that we can try to resolve any concerns promptly and amicably. Periodic statements may be sent which will summarize outstanding invoices. In the event that Client is comprised of more than one legal entity or individual, each such entity or individual shall be jointly and severally responsible for any unpaid invoices.

Client has the right to terminate this engagement at any time, subject to payment of any final billings. Likewise, FZLZ reserves the right to withdraw from the engagement, and from representing Client (subject to the ethical restrictions imposed upon us by the applicable Rules of Professional Responsibility), including in the event that Client fails to cooperate and/or fails to make timely payments as required pursuant to this letter, if Client requests that FZLZ take any position or action that in our good faith opinion requires or permits our withdrawal because of professional duties imposed upon us by the applicable Rules of Professional Responsibility, or if there is an absence of the trust and confidence essential to the attorney-client relationship. Thus, for example, if Client, in FZLZ's judgment, is delinquent in paying the invoiced amounts, FZLZ reserves its right, upon appropriate notice to Client, to take no action on a trademark application or registration, regardless of any impending deadline, even if such failure to act will cause an application or existing registration to lapse. If FZLZ otherwise seeks to terminate this engagement, FZLZ will endeavor to provide reasonable notice to Client.


Finally, please note that Part 137 of the Rules of the Chief Administrator of the courts of the State of New York provides that in certain circumstances a client has the right to require arbitration of disputes relating to legal fees. In the event of the existence of any such disputes, you or your advisor should review Part 137 in order to determine whether you have the right to require arbitration thereunder.

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December 3, 2014  
Page 4

This letter represents the terms of FZLZ's engagement. If you have any questions or concerns about these terms, please contact us immediately. **By signing below you confirm that Client has read, understood and agreed to the terms set forth above and agrees to representation under these terms.**

Very truly yours,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:   
David Donahue

Understood and Agreed by:

BIGFOOT ENTERTAINMENT INC.

\_\_\_\_\_  
By:

Title:

Bigfoot Entertainment Inc.

December 3, 2014

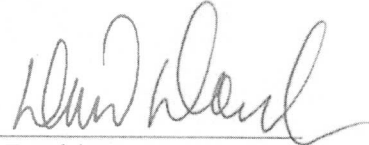
Page 4

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Very truly yours,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

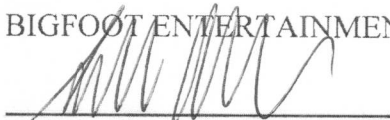
By:



David Donahue

Understood and Agreed by:

BIGFOOT ENTERTAINMENT INC.



By: Gabriel Miller

Title: General Counsel

**Samuel Blaustein**

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**From:** David Donahue <ddonahue@fzlz.com>  
**Sent:** Tuesday, April 07, 2015 5:08 PM  
**To:** Raymond Dowd  
**Cc:** 'Mark Lerner'; 'McNamara, Elizabeth'; Samuel Blaustein; Roger Zissu  
**Subject:** F.TV Ltd. v. Bell Media Inc., No. 14 Civ. 9856 (KBF) (S.D.N.Y.)

Dear Ray,

Pursuant to the Court's endorsed order of April 7, 2015 directing "FZLZ to state whether FTIL directed FZLZ to send the cease-and-desist letters or, in the alternative, to state that no such direction was given," we hereby answer as follows:

We were directed to send the cease-and-desist letters on behalf of FTIL by Gabriel Miller, Esq., whom we understood had authority to do so.

Sincerely,

David Donahue  
Fross Zelnick Lehrman & Zissu, P.C.  
866 United Nations Plaza  
New York, New York 10017  
Phone: 212-813-5900  
Fax: 212-813-5901  
Web: [www.fzlz.com](http://www.fzlz.com)

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